Date

ROUTING AND TRANSMITTAL SLIP

TO: (Name, office symbol, room number, building, Agency/Post)	Initials	Date
1. Ms Schneider		
2.		
3.		
4.		
5.		

GEN... COUNSEL
COPY...

Action	File	Note and Return
Approval	For Clearance	Per Conversation
As Requested	For Correction	Prepare Reply
Circulate	For Your Information	See Me
Comment	Investigate	Signature
Coordination	Justify	

REMARKS

Attached is a copy of the correspondence written in connection with the Winchester Buckle one of the works in the Kiesel stein-Cord case. There was no correspondence in connection with the other work in the case, "Vaquero."

DO NOT use this form as a RECORD of approvals, concurrences, disposals, clearances, and similar actions

FROM: (Name, org. symbol, Agency/Post)	Room No.—Bldg.
RSD 6/4/80	Phone No.

☆U.S. Government Printing Office: 1977—241-530/3507

COPYRIGHT OFFICE
LIBRARY OF CONGRESS
WASHINGTON, D.C. 20559

OFFICE OF THE
REGISTER OF COPYRIGHTS

SEP 13 1977

NDR:btd
9-8-77

Barry Kieselstein Ent. Inc.
57 Park Avenue
New York, New York 10016

Attention: Barry Cord

Re: WINCHESTER BUCKLE and LARGE VICTORIAN DOLL FACE RING WITH TEETH

Dear Mr. Cord:

The copyright statute requires that the "name of the copyright proprietor" be included as a part of the copyright notice. The purpose for this requirement, of course, is to apprise the public of the copyright proprietor's identity. A notice that does not do this is defective and will not support the registration of a claim to copyright.

The copyright notice on the copies of the work you submitted contains only the surname "Kieselstein-Cord." There is some doubt whether the presence of a surname alone in the copyright notice constitutes adequate compliance with the statute. However, in cases where the copies contain the name of no individual with the same surname that might mislead the public as to the identity of the copyright proprietor, registration is made in accordance with our practice of resolving doubtful cases in favor of registration wherever possible. In future works you should make certain the copyright notice contains the full name of the copyright proprietor on all published copies.

Sincerely yours,
Bernard C. Dietz
Head, Arts Section
Examining Division

By: KOK

Enclosure:
Circular R 99

SHOULD BE "NOT"

REMITTER: Kieselstein (Bassy) Ent. Inc.

Attention: Bassy Cord

ADDRESS: 67 Park Ave
New York, N.Y. 10016

TITLE OF WORK: Winchester Buckle and "Large Victorian Doll Face Ring With Teeth"
(give both titles)

CLASS: Gp

CASH NO.: 236620

DATE: 8/22/77

AM'T REC'D: 42.00

AM'T USED: 42.00

INFORMALITY:

- ☐ Excess Fee
- ☐ Misplaced Notice
- ☐ Dispersed Notice
- ☐ Change of Title
- ☐ Certificate(s) Ret'd
- ☐ Information Requested
- ☐ Incorrect Symbol in Notice
- ☐ Correction Requested
- ☒ surname in notice

RECOMMENDATION:

GL 155-A

in par 2: surname "Kieselstein-Cord"

Encl: Circ R99

EXAMINER: KDK

DATE: 8/31/77

REVISER:

DATE:

REC'D IN C. O.: 8/22/77

REC'D IN EXAM: 8/30/77

CROSS REFERENCES:

Form C-247
2/75 5,000

LC 3-120 (2/75)

Barry Kieselstein yes Barry Kieselstein

AUGUST 18,1977

MR. BERNARD C. DIETZ
HEAD, ARTS SECTION
EXAMINING DIVISION
LIBRARY OF CONGRESS
WASHINGTON,D.C. 20540

AUG 22 1977

1/42 00
236620 AUG 22 77

DEAR MR. DIETZ:

ENCLOSED PLEASE FIND SEVEN DIFFERNT APPLICATIONS FOR COPYRIGHT REGISTRATION APPLICATION. ALSO ENCLOSED IS A CHECK IN THE AMOUNT OF $42. FOR SAME. I WONDER IF YOUR OFFICE WOULD BE SO KIND AS TO SEND ME ANY OF THE LATEST MATERIAL REGARDING ANY OF THE CHANGES IN THE COPYRIGHT LAWS IN THE LAST 18MONTHS IF THERE WOULD BE A CHARGE FOR THESE WOULD YOU BE KIND ENOUGH TO BILL FOR SAME,I WOULD APPRECIATE THIS VERY MUCH.

SINCERELY,

BARRY CORD,
DIRECTOR BARRY KIESELSTEIN ENT.INC.

BC/jam

(7) 8/31/77
100

Application
for Registration of a Claim to Copyright
in a work of art or a model or design for a work of art

FORM G

REGISTRATION NO. GP 119073
DO NOT WRITE HERE
GF GFO GP GU

CLASS G

Instructions: Make sure that all applicable spaces have been completed before you submit the form. The application must be **SIGNED** at line 11. For published works the application should not be submitted until after the date of publication given in line 6(a), and should state the facts which existed on that date. For further information, see page 4.

Pages 1 and 2 should be typewritten or printed with pen and ink. Pages 3 and 4 should contain exactly the same information as pages 1 and 2, but may be carbon copies.

Mail all pages of the application to the Register of Copyrights, Library of Congress, Washington, D.C. 20559, together with:

(a) If unpublished, a photograph or other identifying reproduction of the work and the registration fee of $6.

(b) If published, two copies of the best edition of the work (or if appropriate, photographs—see line 4) and the registration fee of $6.

Make your remittance payable to the Register of Copyrights.

1. Copyright Claimant(s) and Address(es): Give the name(s) and address(es) of the copyright owner(s). For published works the name(s) should ordinarily be the same as in the notice of copyright on the copies deposited. If initials are used in the notice, the name should be the same as appears elsewhere on the copies.

Name BARRY KIESELSTEIN-CORD*

Address 67 PARK AVENUE, NEW YORK 10016

Name

Address

2. Title: WINCHESTER BUCKLE
(Give the title of the work as it appears on the copies; a descriptive title may be used where the work is entirely pictorial or sculptural)

3. Nature of Work: SCULPTURE
(Characterize the general type of artistic work involved, as, for example, painting, drawing, sculpture, etc.)

NOTE: Leave line 4 blank unless the work has been PUBLISHED and photographs deposited in lieu of copies.

4. Optional Deposit: (See information on page 4.)

Basis for claiming option (Check and fill in **ONE** of the following):

☐ Monetary value (retail value per copy) ☐ Weight (in pounds)

☐ Size (give dimensions) ☐ Fragility (give details)

5. Author (i.e., Artist): Citizenship and domicile information must be given. Where a work is made for hire, the employer is the author. The citizenship of organizations formed under U.S. Federal or State law should be stated as U.S.A. If the copyright claim is based on new matter (see line 7) give information about the author of new matter.

Name BARRY KIESELSTEIN-CORD Citizenship U.S.A.
(Give legal name followed by pseudonym if latter appears on the copies) (Name of country)

Domiciled in U.S.A. Yes X No ____ Address 67 PARK AVENUE, NEW YORK 10016

NOTE: Leave all spaces of line 6 blank unless your work has been PUBLISHED.

6. (a) Date of Publication: Give the complete date when copies of this particular work were first placed on sale, sold, or publicly distributed. The date when copies were made or printed should not be confused with the date of publication. NOTE: The full date (month, day, and year) must be given.

SEPTEMBER 1 1976**
(Month) (Day) (Year)

(b) Place of Publication: Give the name of the country in which this particular work was first published.

U.S.A.

(c) Manufacture Outside United States by Lithographic or Photoengraving Process: If the copies of this work were manufactured outside the United States by lithographic or photoengraving process, give the name of the country of manufacture.

NOTE: Leave all spaces of line 7 blank unless the instructions below apply to your work.

7. Previous Registration or Publication: If a claim to copyright in any substantial part of this work was previously registered in the U.S. Copyright Office in unpublished form, or if a substantial part of the work was previously published anywhere, give requested information.

Was work previously registered? Yes ____ No ____ Date of registration ____ Registration number ____

Was work previously published? Yes ____ No ____ Date of publication ____ Registration number ____

Is there any substantial **NEW MATTER** in this version? Yes ____ No ____ If your answer is "Yes," give a brief general statement of the nature of the **NEW MATTER** in this version. (New matter may consist of compilation, abridgment, editorial revision, and the like, as well as additional artistic or graphic material.)

EXAMINER EDC V

Complete all applicable spaces on next page

8. If registration fee is to be charged to a deposit account established in the Copyright Office, give name of account:

DNA

9. Name and address of person or organization to whom correspondence or refund, if any, should be sent:

Name KIESELSTEIN-CORD Address 67 PARK AVENUE, NEW YORK 10016

10. Send certificate to:

(Type or print name and address)

Name BARRY KIESELSTEIN-CORD

Address 67 PARK AVENUE
(Number and street)

NEW YORK (City) NEW YORK (State) 10016 (ZIP code)

11. Certification:

(Application not acceptable unless signed)

I CERTIFY that the statements made by me in this application are correct to the best of my knowledge.

(Signature of copyright claimant or duly authorized agent)

Application Forms

Copies of the following forms will be supplied by the Copyright Office without charge upon request.

Class A — Form A—Published book manufactured in the United States of America.

Class A or B —
- Form A-B Foreign—Book or periodical manufactured outside the United States of America (except works subject to the ad interim provisions of the copyright law).
- Form A-B Ad Interim—Book or periodical in the English language manufactured and first published outside the United States of America.

Class B —
- Form B—Periodical manufactured in the United States of America.
- Form BB—Contribution to a periodical manufactured in the United States of America.

Class C — Form C—Lecture or similar production prepared for oral delivery.

Class D — Form D—Dramatic or dramatico-musical composition.

Class E —
- Form E—Musical composition the author of which is a citizen or domiciliary of the United States of America or which was first published in the United States of America.
- Form E Foreign—Musical composition the author of which is not a citizen or domiciliary of the United States of America and which was not first published in the United States of America.

Class F — Form F—Map.

Class G — Form G—Work of art or a model or design for a work of art.

Class H — Form H—Reproduction of a work of art.

Class I — Form I—Drawing or plastic work of a scientific or technical character.

Class J — Form J—Photograph.

Class K —
- Form K—Print or pictorial illustration.
- Form KK—Print or label used for an article of merchandise.

Class L or M — Form L-M—Motion picture.

Class N — Form N—Sound recording.

Form R—Renewal copyright.

Form U—Notice of use of musical composition on mechanical instruments.

FOR COPYRIGHT OFFICE USE ONLY		
Application received AUG 22 1977	Two copies received AUG 22 1977	Photographs or reproductions received
One copy or reproduction received	* IN NOTICE: KIESELSTEIN-CORD (Cert.)	
Fee received 236620 AUG 22 77	** Year date in notice: 1977 (Appl.)	
Renewal		

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 1351—September Term, 1979

(Argued June 19, 1980 Decided September 18, 1980)

Docket No. 80-7354

BARRY KIESELSTEIN-CORD,

Plaintiff-Appellant,

v.

ACCESSORIES BY PEARL, INC.,

Defendant-Appellee.

B e f o r e :

OAKES and VAN GRAAFEILAND, *Circuit Judges,*
and WEINSTEIN, *District Judge.**

Appeal from a grant of summary judgment on copyright infringement claims in favor of defendant-appellee in the United States District Court for the Southern District of New York, Gerard L. Goettel,

* Of the Eastern District of New York, sitting by designation.

Judge, holding that two belt buckles designed by plaintiff-appellant may not be copyrighted under federal copyright laws and regulations.

Reversed and remanded for further proceedings.

JANET P. KANE (Ronald J. Levine, Phillips, Nizer, Benjamin, Krim & Ballon, New York, New York, on the brief), *for Plaintiff-Appellant.*

WILLIAM F. DUDINE, JR. (David R. Francescani, Darby & Darby P.C., New York, New York, on the brief), *for Defendant-Appellee.*

CHARLES R. REEVES, JOHN C. MCNETT, C. DAVID EMHARDT, Woodard, Weikart, Emhardt & Naughton, Indianapolis, Indiana, *for LaVenta Corporation d/b/a Indiana Metal Craft* as Amicus Curiae.

OAKES, *Circuit Judge:*

This case is on a razor's edge of copyright law. It involves belt buckles, utilitarian objects which as such are not copyrightable. But these are not ordinary buckles; they are sculptured designs cast in precious metals—decorative in nature and used as jewelry is, principally for ornamentation. We say "on a razor's edge" because the case requires us to draw a fine line under applicable copyright law and regulations. Drawing the line in favor of the appellant designer, we

the appellant's contribution was listed on the certificate as "original sculpture and design." Explaining why he named the earlier buckle design "Winchester," the designer said that he saw "in [his] mind's eye a correlation between the art nouveau period and the butt of an antique Winchester rifle" and then "pulled these elements together graphically." The registration, which is recorded on a form used for works of art, or models or designs for works of art, specifically describes the nature of the work as "sculpture."

The Winchester buckle in particular has had great success in the marketplace: more than 4,000 belts with Winchester buckles were sold from 1976 to early 1980, and in 1979 sales of the belts amounted to 95% of appellant's more than $300,000 in jewelry sales. A small women's size in silver with "double truncated triangle belt loops" sold, at the time this lawsuit commenced, at wholesale for $147.50 and a larger silver version for men sold at wholesale with loops for $662 and without loops for $465. Lighter-weight men's versions in silver wholesaled for $450 and $295, with and without loops respectively. The gold versions sold at wholesale from $1,200 to $6,000. A shortened version of the belt with the small Winchester buckle is sometimes worn around the neck or elsewhere on the body rather than around the waist. Sales of both buckles were made primarily in high fashion stores and jewelry stores, bringing recognition to appellant as a "designer." This recognition included a 1979 Coty American Fashion Critics' Award for his work in jewelry design as well as election in 1978 to the Council of Fashion Designers of America. Both the Winchester and the Vaquero buckles, donated by appellant after this lawsuit was commenced, have been accepted by the

Metropolitan Museum of Art for its permanent collection.

As the court below found, appellee's buckles "appear to be line-for-line copies but are made of common metal rather than" precious metal. Appellee admitted to copying the Vaquero and selling its imitations, and to selling copies of the Winchester. Indeed some of the order blanks of appellee's customers specifically referred to "Barry K Copy," "BK copy," and even "Barry Kieselstein Knock-off." Thus the only legal questions for the court below were whether the articles may be protected under the copyright statutes and, if so, whether the copyrights were adequate under the laws. Having found that the copyrights were invalid—the Winchester under the Copyright Act of 1909, and the Vaquero under the 1976 Act[1]—because they "fail[ed] to satisfy the test of separability and independent existence of the artistic features, which is required under both statutes," Judge Goettel did not go on to make a conclusive determination on the further question whether the notice requirements of the acts had been met by appellant. Instead, he found that the Winchester buckle "probably" satisfies the 1909 Act notice requirements, and he reserved the question whether, with respect to the Vaquero buckle, appellant met the notice requirements of the 1976 Act by way of a saving clause that preserves a copyright despite publication without adequate notice, 17 U.S.C § 405. We therefore only reach the question whether the buckles may be copyrighted.

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1 The Winchester buckle was registered before the January 1, 1978, effective date of the Copyright Act of 1976.

DISCUSSION

We commence our discussion by noting that no claim has been made that the appellant's work here in question lacks originality or creativity, elements necessary for copyrighting works of art. *See L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951); 1 *Nimmer on Copyright* §§ 2.01, 2.08[B] (1980). The thrust of appellee's argument, as well as of the court's decision below, is that appellant's buckles are not copyrightable because they are "useful articles" with no "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects" of the buckles. The 1976 copyright statute does not provide for the copyrighting of useful articles except to the extent that their designs incorporate artistic features that can be identified separately from the functional elements of the articles. *See* 17 U.S.C. §§ 101, 102.[2] With respect

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2 17 U.S.C. § 101 provides in relevant part:

> As used in this title, the following terms and their variant forms mean the following:
>
> * * * * *
>
> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.
>
> * * * * *

(footnote continued on next page)

to this question, the law adopts the language of the longstanding Copyright Office regulations, 37 C.F.R. § 202.10(c) (1977)[3] (revoked Jan. 5, 1978, 43 Fed. Reg. 965, 966 (1978)). The regulations in turn were adopted in the mid-1950's, under the 1909 Act, in an effort to implement the Supreme Court's decision in *Mazer v. Stein*, 347 U.S. 201 (1954). *See* H.R. Rep. No. 1476,

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A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article".

17 U.S.C. § 102 provides generally for copyright protection of "pictorial, graphic, and sculptural works."

3 37 C.F.R. § 202.10, *reprinted in* 4 *Nimmer on Copyright*, App. 11, at 11-13 to 11-14 (1980), provided as follows:

Works of Art (Class G)

(a) General[.] This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture. [Revoked Jan. 1, 1978, 43 Fed. Reg. 965, 966 (1978).]

(b) In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile material or textile product. The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been issued. [Current version at 37 C.F.R. § 202.10(b) (1979).]

(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration. [Revoked Jan. 1, 1978, 43 Fed. Reg. 965, 966 (1978).]

94th Cong., 2d Sess. 54-55 (1976), *reprinted in* [1976] U.S. Code Cong & Ad. News 5659, 5668 [hereinafter cited as *House Report*]. The Court in *Mazer*, it will be recalled, upheld the validity of copyrights obtained for statuettes of male and female dancing figures despite the fact that they were intended for use and used as bases for table lamps, with electric wiring, sockets, and lampshades attached. *Mazer* itself followed a "contemporaneous and long-continued construction" by the Copyright Office of the 1870 and 1874 Acts as well as of the 1909 Act, under which the case was decided. 347 U.S. at 211-13. As Professor Nimmer points out, however, the Copyright Office's regulations in the mid-1950's that purported to "implement" this decision actually limited the Court's apparent open-ended extension of copyright protection to all aesthetically pleasing useful articles. *See* 1 Nimmer, *supra*, § 2.08[B], at 2-88 to 2-89.

Ultimately, as Professor Nimmer concludes, none of the authorities—the *Mazer* opinion, the old regulations, or the statute—offer any "ready answer to the line-drawing problem inherent in delineating the extent of copyright protection available for works of applied art." *Id.* at 2-89. Congress in the 1976 Act may have somewhat narrowed the sweep of the former regulations by defining a "useful article" as one with "*an* intrinsic utilitarian function," 17 U.S.C. § 101 (emphasis added), instead of one, in the words of the old regulations, with utility as its "*sole* intrinsic function," 37 C.F.R. § 202.10(c) (1977) (revoked Jan. 5, 1978, 43 Fed. Reg. 965, 966 (1978)) (emphasis added).

We are left nevertheless with the problem of determining when a pictorial, graphic, or sculptural feature "can be identified separately from, and [is]

capable of existing independently of, the utilitarian aspects of the article," 17 U.S.C. § 101. This problem is particularly difficult because, according to the legislative history explored by the court below, such separability may occur either "physically or conceptually," *House Report* at 55, [1976] U.S. Code Cong. & Ad. News at 5668. As the late Judge Harold Leventhal observed in his concurrence in *Esquire, Inc. v. Ringer*, 591 F.2d 796, 807 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), legislative policy supports the Copyright Office's "effort to distinguish between the instances where the aesthetic element is conceptually severable and the instances where the aesthetic element is inextricably interwoven with the utilitarian aspect of the article."[4] Examples of conceptual separateness as an artistic notion may be found in many museums today and even in the great outdoors. Professor Nimmer cites Christ's "Running Fence" as an example of today's "conceptual art": it "did not contain sculptural features that were physically separable from the utilitarian aspects of the fence, but the whole point of the work was that the artistic aspects of the work were conceptually separable." 1 Nimmer, *supra*, § 2.08[B] at 2-94.

Appellee argues that the belt buckles are merely useful objects, which include decorative features that serve an aesthetic as well as a utilitarian purpose. And the copyright laws, appellee points out, were never intended to nor would the Constitution permit them to

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4 The court of appeals in the *Esquire* case reversed Judge Gesell's finding of conceptual separateness in the overall artistic design of an outdoor lighting fixture, 414 F. Supp. 939 (D.D.C. 1976). *See* 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied,* 440 U.S. 908 (1979).

protect monopolies on useful articles. But appellee goes too far by further arguing that "copyrightability cannot adhere in the 'conceptual' separation of an artistic element." Brief for Defendant-Appellee at 17. This assertion flies in the face of the legislative intent as expressed in the House Report, which specifically refers to elements that "physically or conceptually, can be identified as separable from the utilitarian aspects of" a useful article. *House Report* at 55, [1976] U.S. Code Cong. & Ad. News at 5668.

We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist. The primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function. This conclusion is not at variance with the expressed congressional intent to distinguish copyrightable applied art and uncopyrightable industrial design, *House Report* at 55, [1976] U.S. Code Cong. & Ad. News at 5668. Pieces of applied art, these buckles may be considered jewelry, the form of which is subject to copyright protection, *Boucher v. Du Boyes, Inc.*, 253 F.2d 948, 949 (2d Cir.), *cert. denied*, 357 U.S. 936 (1958); *Cynthia Designs, Inc. v. Robert Zentall, Inc.*, 416 F. Supp. 510, 511-12 (S.D.N.Y. 1976); *Trifari, Krussman & Fishel, Inc. v. Charel Co.*, 134 F. Supp. 551, 552-53 (S.D.N.Y. 1955).[5]

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5 These cases were decided under the old Copyright Act of 1909, which protected "all the writings of an author," 17 U.S.C. § 4 (1976), and which included as one of the classes to which copyrighted work might belong "works of art; models or designs for works of art," *id.* § 5. Regulations promulgated under the 1909 Act listed "artistic jewelry" as an example of "works of art." 37 C.F.R. § 202.10(a) (1977), see note 3 *supra*.

(footnote continued on next page)

Appellant's designs are not, as the appellee suggests in an affidavit, mere variations of "the well-known western buckle." As both the expert witnesses for appellant testified and the Copyright Office's action implied, the buckles rise to the level of creative art. Indeed, body ornamentation has been an art form since the earliest days, as anyone who has seen the Tutankhamen or Scythian gold exhibits at the Metropolitan Museum will readily attest. The basic requirements of originality and creativity, which the two buckles satisfy and which all works of art must meet to be copyrighted, would take the vast majority of belt buckles wholly out of copyrightability. The Copyright Office continually engages in the drawing of lines between that which may be and that which may not be copyrighted. It will, so long as the statute remains in its present form, always be necessary to determine whether in a given case there is a physically or conceptually separable artistic sculpture or carving capable of existing independently as a work of art.

We reverse the grant of summary judgment to the appellee and remand the case for consideration of whether appellant has satisfied the copyright notice requirements.

The current statute extends copyright protection to "pictorial, graphic, and sculptural works," 17 U.S.C. § 102(a)(5), and notes that, in the words of the old regulation, 37 C.F.R. § 202.10(a) (1977), see note 3 *supra*, "[s]uch works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." 17 U.S.C. § 101, see note 2 *supra*. The new statute, while incorporating this regulatory definition, omits the specific examples, such as "artistic jewelry," listed in the old regulations. This omission does not suggest that jewelry may not be copyrighted. In fact, the explicit congressional adoption of the Copyright Office's definition indicates that jewelry remains within the scope of copyright protection.

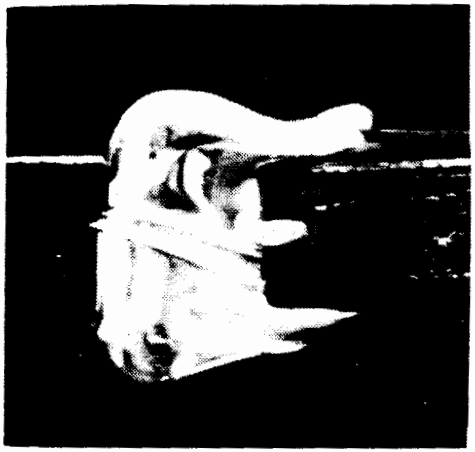
WEINSTEIN, *District Judge,* (Dissenting):

The trial judge was correct on both the law and the facts for the reasons given in his excellent opinion holding that plaintiff was not entitled to copyright protection. *Kieselstein-Cord v. Accessories By Pearl, Inc.,* 489 F.Supp. 732 (S.D.N.Y. 1980). The works sued on are, while admirable aesthetically pleasing examples of modern design, indubitably belt buckles and nothing else; their innovations of form are inseparable from the important function they serve—helping to keep the tops of trousers at waist level.

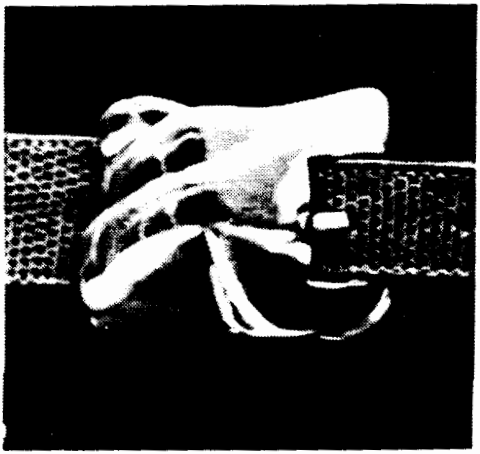
The conclusion that affirmance is required is reached reluctantly. The result does deny protection to designers who use modern three-dimensional abstract works artfully incorporated into a functional object as an inseparable aspect of the article while granting it to those who attach their independent representational art, or even their trite gimmickry, to a useful object for purposes of enhancement. Moreover, this result enables the commercial pirates of the marketplace to appropriate for their own profit, without any cost to themselves, the works of talented designers who enrich our lives with their intuition and skill. The crass are rewarded, the artist who creates beauty is not. All of us are offended by the flagrant copying of another's work. This is regrettable, but it is not for this court to twist the law in order to achieve a result Congress has denied.

Both of appellant's designs may be described as rough geometric shapes with uneven surfaces, one of them having two wavy lines in the corner. These arrangements are embodied within a useful article—a belt buckle. They transform the ordinary square buckle—

with each of its sides of equal width, and a narrow tongue attached to one side—into a four sided structure with sides of unequal thickness and the usual narrow tongue. The artist has enhanced the appearance of the buckles by rendering their shape aesthetically pleasing without interfering with function. It is the originator's success in completely integrating the artistic designs and the functional aspects of the buckles that preclude copyright.



Winchester



Vaquero

The 1976 Copyright Act protects only those portions of useful articles, such as belt buckles, consisting of "sculptural features that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article." In relevant portions, the copyright law, title 17 of the United States Code, reads:

§ 101. Definitions

* * * * *

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; *the design of a useful article,* as defined in this section, shall be considered a pictorial,. graphic, or sculptural work only if, *and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.*

* * * * *

A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. *An article that is normally a part of a useful article is considered a "useful article".*

§ 102. Subject matter of copyright: In general.

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. *Works of authorship* include the following categories:

* * * * *

(5) *pictorial, graphic, and sculptural works;*

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

(Emphasis supplied.)

The statute follows the decision of the Supreme Court in *Mazer v. Stein,* 34 U.S. 20, 74 S.Ct. 460, *rehearing denied,* 347 U.S. 949, 74 S.Ct. 637 (1954). In *Mazer,* the Court held that independent works of art may be copyrighted even if they are incorporated into useful articles—"nothing in the copyright statute . . . support[s] the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration." *Id.* at 218, 74 S.Ct. at 471. But the copyright protection covered only that aspect of the article that was a separately identifiable work of art independent of the useful article, in that instance a statuette used as part of a lamp.

Among recent decisions making this same distinction is *Esquire v. Ringer,* 591 F.2d 796 (D.C. Cir.), *cert. denied,* 440 U.S. 908, 99 S.Ct. 1217, *rehearing denied,* 441 U.S. 917, 99 S.Ct. 2019 (1979). *Esquire* denied copyright protection to the overall shape of a lighting fixture because of its integration of the functional aspects of the entire lighting assembly. The "overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright." *Id.* at 804.

While the distinction is not precise, the courts, both before and after *Mazer,* have tried to follow the

principle of the copyright act permitting copyright to extend only to ornamental or superfluous designs contained within useful objects while denying it to artistically designed functional components of useful objects. Generally they have favored representational art as opposed to non-representation artistic forms which are embodied in, and part of the structure of, a useful article. *Compare, e.g., Ted Arnold Ltd. v. Silvercraft Co.,* 259 F.Supp. 733 (S.D.N.Y. 1966) (antique telephone used to encase a pencil sharpener copyrightable); *Royalty Designs Inc. v. Thrifticheck Service Corp.,* 204 F.Supp. 702 (S.D.N.Y. 1962) (toy banks in shape of dogs copyrightable); *Scarves by Vera, Inc. v. United Merchants and Mfrs., Inc.,* 173 F.Supp. 625 (S.D.N.Y. 1959) (designs printed upon scarves copyrightable); *Syracuse China Corp. v. Stanley Roberts, Inc.,* 180 F.Supp. 527 (S.D.N.Y. 1960) (designs on dinnerware copyrightable) *with Esquire v. Ringer,* 591 F.2d 796 (D.C. Cir.), *cert. denied,* 440 U.S. 908, *rehearing denied,* 441 U.S. 917 (1979) (copyright denied to overall design of lighting fixture); *SCOA Industries, Inc. v. Famulare, Inc.,* 192 U.S.P.Q. 216 (S.D.N.Y. 1976) (wavy lines on soles of shoes not copyrightable); *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.,* 155 F.Supp. 932 (S.D.N.Y. 1957), *affirmed in part, reversed on other grounds,* 260 F.2d 637 (2d Cir. 1958) (artistically designed non-representational watchface not copyrightable); *Russell v. Trimfit, Inc.,* 428 F.Supp. 91 (E.D. Pa. 1977), *affirmed* 568 F.2d 770 (3d Cir. 1978) (designs of "toe socks" not copyrightable); *Jack Adelman, Inc. v. Sommers & Gordon, Inc.,* 112 F.Supp. 187 (S.D.N.Y. 1934) (picture of a dress may be copyrighted but the dress itself may not be). The relative certainty that has developed in

this area of the law should not be disturbed absent some compelling developments—and none have thus far been presented.

Interpretation and application of the copyright statute is facilitated by House Report No. 94-1476, by the Committee on the Judiciary. It explicitly indicated that the rule of *Mazer* was incorporated.

> In accordance with the Supreme Court's decision in *Mazer v. Stein,* 347 U.S. 201 (1954), works of "applied art" encompass all original pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection. . . .
>
> The Committee has added language to the definition of "pictorial, graphic, and sculptural works" in an effort to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection. The declaration that "pictorial, graphic, and sculptural works" include "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned" is classic language: it is drawn from Copyright Office regulations promulgated in the 1940's and expressly endorsed by the Supreme Court in the *Mazer* case.
>
> * * * * *
>
> In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and

uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, *although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill.* Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually can be identified as separable from the utilitarian aspects of that article" does not depend upon the nature of the design—that is, even if the appearance of an article is determined by aesthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. *And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the overall configuration of the utilitarian article as such.*

1976 U.S. Code Cong. & Admin. News, 5667-5668. (Emphasis supplied.)

Congress considered and declined to enact legislation that would have extended copyright protection to "[t]he

'design of a useful article' . . . including its two-dimensional or three-dimensional features of shape and surface, which make up the appearance of the article." H.R. 2223, Title II, § 201(b)(2), 94th Cong., 1st Sess. (January 28, 1975). Passage of this provision was recommended by the Register of Copyrights, Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary (Oct. 30, 1975) (testimony of Barbara Ringer), Reprinted in 16 Omnibus Copyright Revision Legislative History, 1855-59 (1975), and the United States Department of Commerce, Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary (May 8, 1975) (testimony and statement of Rene Tegtmeyer), Reprinted in 14 Omnibus Copyright Revision Legislative History, 161-162, 166-169. It was opposed by the Department of Justice on policy grounds. Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary (May 8, 1975) (testimony of Irwin Goldbloom), Reprinted in 14 Omnibus Copyright Revision Legislative History, 127-130, 139-141. The Justice Department noted the important substantive objections to the proposal—primarily it would charge the public a fee for the use of improved and pleasing new designs and styles in useful articles.

> Of particular concern to this Department is the new form of copyright protection provided by title II of the bill.
>
> This new form of protection is a hybrid between design patents, 35 U.S.C. 171-173, issued for a

period of up to 14 years by the Patent Office for new, original and ornamental designs of articles of manufacture and the copyright laws which provide for registration and issuance of certificates of copyrights for the writings of authors. The new protection that is provided under the bill is not presently available under the copyright laws and can only be obtained through a design patent after an examination procedure which determines whether the ornamental design meets the criteria of patentability, including unobviousness in view of the prior art, as provided by 35 U.S.C. 102, 103.

While the protection period as proposed for the new type of ornamental design protection is only a maximum of 10 years as compared with the maximum of 14 years available for a design patent, it is granted without the need of meeting the novelty and unobviousness requirements of the patent statute.

A threshold consideration before finding that the needs are such that this new type of protection should be available *is whether the benefits to the public of such protection outweigh the burdens. We believe that insufficient need has been shown to date to justify removing from the public domain and possible use by others of the rights and benefits proposed under the present bill for such ornamental designs.* We believe that design patents, as are granted today, are as far as the public should go to grant exclusive rights for ornamental designs of useful articles in the absence of an adequate showing that the new protection will provide substantial benefits to the general public

which outweigh removing such designs from free public use.

While it has been said that the examination procedure in the Patent Office results in serious delays in the issuance of a design patent so as to be a significant problem and damaging to "inventors" of ornamental designs of useful articles, *the desirable free use of designs which do not rise to patentable invention of ornamental designs of useful articles are believed* to be paramount.

If the contribution made to the public by the creation of an ornamental design of a useful article is insufficient to rise to patentable novelty, the design should not be protected by the law. The Department of Justice has consistently opposed legislation of this character.

To omit Federal statutory protection for the form of a useful object is not to deny the originator of that form any remedy whatsoever. If he can prove that competitors are passing their goods as the originator's by copying the product's design, he may bring an unfair competition action against such copyists.

Id. at 139-140 (Emphasis supplied.)

No additional testimony was received with respect to this aspect of the House bill. The Joint Senate-House Conference Committee deleted the design protection section to give further consideration to its administrative difficulties and to the benefits and burdens created by limiting the free public domain. 1976 U.S. Code Cong. & Admin. News, 5663, 5832. The attempt to gain protection was again mounted when Representative

Thomas F. Railsback introduced H.R. 4530 on June 19, 1979 to amend the Copyright Act of 1976. H.R. 4530's section 902 contains protections for the design of useful objects identical to those omitted from the 1976 Copyright Act. It was not adopted by Congress.

Interestingly, even if the design protection section proposed by the Department of Commerce and Representative Railsback had been passed, appellant's buckles might still have been excluded under the following subsection excluding three-dimensional features of apparel:

> DESIGNS NOT SUBJECT TO PROTECTION
>
> § 202. *Protection under this title shall not be available for a design that is—*
>
> * * * * *
>
> (e) *composed of three-dimensional features of shape and surface with respect to men's, women's and children's apparel,* including undergarments and outerwear.

(Emphasis supplied.) *See also* proposed § 202(b) (shape which has become common); § 202(c) (variants).

The distinctions between copyrightable "pictorial, graphic and sculptural works" and noncopyrightable industrial "designs" reflect serious concerns about the promotion of competition, the widespread availability of quality products and the advancement of technology through copying and modification. *See, e.g.,* G. Nelson, Design, 170 (1979) (experience suggests that free copying results in more rapid development); Comment, Copyright Protection for Mass Produced, Commercial Products: A Review of the Developments Following *Mazer v. Stein,* 38 U. Chi. L. Rev. 807, 819-22 (1971);

Note, Protection for the Artistic Aspects of Articles of Utility, 72 Harv. L. Rev. 1520, 1532-4 (1959). A similar need to balance societal interest in the availability of literary and dramatic works against the copyright holders' interest in their exclusive enjoyment is reflected in the fair use provisions of the Copyright Act of 1976. 17 U.S.C. §§ 107-112. *See also, e.g.,* Note, Copyright Infringement and the First Amendment, 79 Col. L. Rev. 320 (1979); Ramos, The Betamax Case: Accommodating Public Access and Economic Incentive in Copyright Law, 11 Intellectual Property L. Rev. 221, 230-1 (1979).

Important policies are obviously at stake. Should we encourage the artist and increase the compensation to the creative? Or should we allow cheap reproductions which will permit our less affluent to afford beautiful artifacts? Appellant sold the original for $600.00 and up. Defendant's version went for one-fiftieth of that sum.

Thus far Congress and the Supreme Court have answered in favor of commerce and the masses rather than the artists, designers and the well-to-do. Any change must be left to those higher authorities. The choices are legislative not judicial.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

- -x

BARRY KIESELSTEIN-CORD, : 80 Civ. 1029 (GLG)

Plaintiff, :

-against- :

ACCESSORIES BY PEARL, INC., : O P I N I O N

Defendant, :

- -x

A P P E A R A N C E S :

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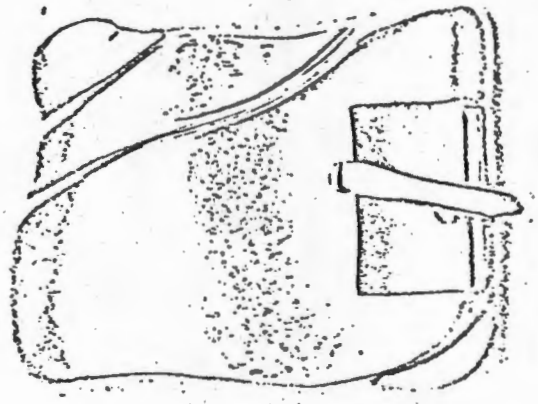
G O E T T E L, D. J.:

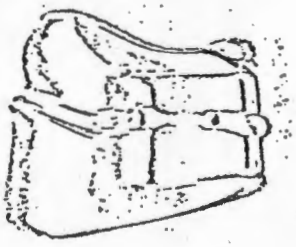
Plaintiff Barry Kieselstein-Cord is the designer of two belt buckles called the Winchester Buckle and the Vaquero Buckle, copies of which he alleges defendant Accessories By Pearl, Inc. has made, sold, distributed, and/or advertised. In this suit for copyright infringement, trademark infringement, and unfair competition, plaintiff has moved for a preliminary injunction and both parties have moved for summary judgment on the copyright claims. After evidentiary hearings on those motions, the Court denies plaintiff's motion for a preliminary injunction or summary judgment and grants defendant's motion for summary judgment. 1/

Plaintiff's buckles are both made of silver, or other precious metal. The Vaquero Buckle is roughly rectangular, with rounded corners, a sculpted surface, and a rectangular cut-out at one end for the belt attachment. It has several surface levels, giving the appearance of two grooves cut across one corner and another at the diagonally opposite corner. The Winchester Buckle is somewhat more irregularly shaped, also with a rectangular cut-out for the belt attachment. There is a tapered, wavy groove cut where the tongue of the buckle would fit and a smaller (almost imperceptible) separate level at a corner near the belt. Defendant's buckles appear to be line-for-line copies,

but are made of common metal rather than silver.



VAQUERO



WINCHESTER

Plaintiff has registered a claim to copyright for each buckle: for the Winchester, Registration No. GP-119073, effective August 22, 1977; for the Vaquero, Registration No. VA-43-985, effective March 3, 1980 (after the commencement of this action). Defendant admits to copying and selling its

copies of the Vaquero and to selling copies of the Winchester. Thus, on the questions of copyright infringement of the Vaquero Buckle and the Winchester Buckle, there remain only the legal issues of the validity of the copyrights and the adequacy of the notice under the copyright statutes.

During expedited discovery and the evidentiary hearings on the copyright claims, defendant has been restrained from continuing to sell or distribute the two buckles by a stipulation regarding the Winchester copies and a temporary restraining order regarding the Vaquero copies. The hearings on the copyright claims are complete, and, since there is "no genuine issue as to any material fact," Fed. R. Civ. P. 56(c), the Court is in a position to rule on the summary judgment motions. Hence, it is unnecessary to consider separately the motion for a preliminary injunction.

The threshold question in determining if plaintiff has valid copyright in the Winchester Buckle and the Vaquero Buckle is whether these belt buckles are copyrightable subject matter. We begin with a presumption that these belt buckles are copyrightable, since the Copyright Office registered plaintiff's claims to copyright. Under both the Copyright Act of 1909 ("1909 Act") and the Copyright Act of 1976 ("1976 Act"), registration by the Copyright Office is prima facie evidence of copyrightability, as well as of the information contained in the registration certificate. 1909 Act, 17 U.S.C. § 209 (1976) (repealed by 1976 Act);

1976 Act, 17 U.S.C. § 410(c) (Supp. I 1977). This presumption is not conclusive, however; it merely shifts the burden of proof. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 157 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5773. Despite this initial judicial deference to the expertise of the Copyright Office, its decisions are subject to review by the courts. Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958).

Under the two statutes and the regulations promulgated thereunder, as well as under the relevant case law, the Winchester Buckle and the Vaquero Buckle are not copyrightable subject matter. Although plaintiff asserts that the buckles are jewelry or sculpture, they appear to be primarily belt buckles. Belt buckles are utilitarian objects designed to fasten belts and thus hold up or hold in a dress, skirt, or pants. Like most utilitarian objects, particularly those worn or carried on the person or used in the home, belt buckles may also be decorative.

A substantial body of law has developed on the subject of the copyrightability of utilitarian objects. Copyright protection was originally granted only to authors of maps, charts, and books and was not expanded to include three-dimensional works of art until 1870. Mazer v. Stein, 347 U.S. 201, 208-09 (1954). Although the Copyright Office interpreted "works of art" broadly enough to include objects with utilitarian aspects, id. at 211-13, some courts did not. Id. at 203. The Supreme Court, in Mazer v. Stein, supra, settled the issue, holding that the use or intended

use of statuettes of dancing figures, which were otherwise eligible for copyright, as bases for table lamps did not bar or invalidate their registration. The Court's reasoning involved two steps: first, the holding that the statuettes were independently copyrightable as works of art, id. at 214; and second, the holding that their use as lamp bases did not destroy their copyrightability.

The regulations adopted by the Copyright Office in the mid-1950's and modified in 1959 were an attempt to retain and refine the Mazer distinction between the work of art and its incorporation in a useful object such as a lamp. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54-55 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5668. The regulations on works of art[2/] permitted the copyrighting of "works of artistic craftsmanship" regardless of the "intention of the author as to the use of the work." 37 C.F.R. § 202.10(a),(b). The regulations required, however, that the artistic features incorporated in the utilitarian object be separately identifiable and "capable of existing independently as a work of art." Id. § 202.10(c).

The requirement of separability and capability of independent existence for the artistic features to be copyrighted was emphasized in the principal case that treats extensively the question of copyrightability of utilitarian objects. The court in Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), held that lighting fixtures designed with unusual elliptically shaped housings were not eligible for copyright protection as works of art because there were no

separately identifiable artistic elements. The court noted that Congress, in its most recent pronouncement on the issue in considering the 1976 Act, unequivocally found ineligible for copyright "the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations." Id. at 804.

The 1976 Act further refined the test for copyrightability of useful articles. It defines the term as follows: "A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article'." 17 U.S.C. § 101 (Supp. I 1977). In addition, the 1976 Act retains and enacts the separability and independent existence requirement of the 1959 regulations. See id.[3/]

The Winchester Buckle, which was first issued on September 1, 1976, must be considered under the 1909 Act, the regulations promulgated thereunder, and the relevant case law. The Vaquero Buckle was first issued on June 1, 1978, and thus must be considered under the 1976 Act, which became effective on January 1, 1978. The tests of copyrightability under the two acts appear to be virtually the same, however, since the 1976 Act essentially incorporates the case law and regulations under the 1909 Act.

Both buckles are uncopyrightable subject matter under

either statute because they fail to satisfy the test of separability and independent existence of the artistic features, which is required under both statutes. The Court does not see in these buckles "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of" the buckles. 17 U.S.C. § 101 (Supp. I 1977); see 37 C.F.R. § 210(c) (1977). Nor does plaintiff identify such features. Instead, the simple, sculptural form of the buckles seems to be very similar to the "overall design or configuration of a utilitarian object" that the Esquire court found uncopyrightable. 591 F.2d at 804. As the Esquire court pointed out, the Supreme Court in Mazer dealt with a different sort of issue. Id. at 804-05. In Mazer, the statuettes were clearly copyrightable subject matter capable of independent existence, and the only real question was whether their use as lamp bases destroyed their copyrightability. Here, each of the buckles is all one form, which, although pleasing, serves a utilitarian purpose. One cannot imagine the buckles or any part of them existing independently as sculpture in the way that the Mazer statuettes could exist.

The cases plaintiff cites in support of the copyrightability of his belt buckles are distinguishable. Mazer, as we have noted, is distinguishable because the statuettes are capable of existing as works of art independent of the utilatarian objects into which they are incorporated. As the legislative history of the

1976 Act makes clear, only the separable artistic features of utilitarian objects are copyrightable, such as the carving on the back of a chair (but not the chair, no matter how beautifully and originally designed). H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5668.

Cynthia Designs, Inc. v. Robert Zentall, Inc., 416 F. Supp. 510 (S.D.N.Y. 1976), and Boucher v. DuBoyes, Inc., 253 F.2d 948 (2d Cir.), cert. denied, 357 U.S. 936 (1958), are distinguishable because they concern jewelry, which has been expressly recognized under the regulations as a special category within the general category of works of art. 37 C.F.R. § 202.10(a) (1977). See note 2 supra. Although it is possible to see belt buckles as jewelry under 37 C.F.R. § 202.10(a), they are more appropriately categorized as utilitarian articles under 37 C.F.R. § 202.10(c). Boucher is further distinguishable on the ground that it was decided before the refinement of the Mazer test in the 1959 regulations.

Syracuse China Corp. v. Stanley Roberts, Inc., 180 F. Supp. 527 (S.D.N.Y. 1960), and William A. Meier Glass Co. v. Anchor Hocking Glass Corp., 95 F. Supp. 264 (W.D. Pa. 1951), which plaintiff also cites in support of copyrightability, do concern useful objects, as the jewelry cases do not. The copyrights in these cases, however, were for the designs on plates and glassware, not for the plates and glassware themselves. These designs, thus, satisfy the separability requirement, whereas the buckle designs do not.

Dan Kasoff, Inc. v. Gresco Jewelry Co., 204 F. Supp. 694 (S.D.N.Y.), aff'd, 308 F.2d 806 (2d Cir. 1962), concerns a copyright on a small ornamental box. The court in Dan Kasoff discusses the issue of copyrightability very briefly, relying primarily on Mazer and making no mention of the test of separability. Since no description of the box is included, except that it was "ornamental" and had a "highly stylized cover," id. at 694, it is difficult to say whether satisfaction of the separability requirement was an issue there as it is here.

Plaintiff argues that his belt buckles are so unusual and ornamental that they constitute sculpture. There no longer is anything remotely resembling a standard belt buckle. There are many thousands of different designs for buckles which are, to varying degrees, ornamental. Even if we agree with plaintiff that his designs are particularly pleasing, that does not exalt their status as belt buckles. Under plaintiff's approach, virtually every new design for a belt buckle could properly be copyrighted.

The belt buckles in this case seem to belong more to the world of fashion design than to the world of literature and art, which is the traditional domain of copyright law. The status of designs for clothing is instructive. The design superimposed on a fabric is copyrightable, whereas the style of the dress (even an expensive Parisian couturier's design) in which the fabric is used is not -- no matter how original, ornamental, or nonessential for function that design may be. 1 M. Nimmer, Nimmer on Copyright

§ 2.08[H] (1979). The fabric design can be seen as a separable artistic element, whereas the overall dress design -- like the overall shape of the belt buckle -- cannot.

Since copyright law is statutory, congressional intent should be accorded great weight. The wording of the 1976 Act demonstrates Congress's concern with distinguishing separable artistic features of useful articles, which are copyrightable, from useful articles themselves, which are not copyrightable. The House Report on the 1976 Act makes the distinction even more explicit:

> The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design--that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5668. Finally, Congress has demonstrated its intention that useful articles not be copyrightable by its rejection -- most recently in 1976 -- of copyright protection for original designs for consumer and industrial products. See Esquire v. Ringer, supra, 591 F.2d at 800. Proposed Title II of the 1976 Act would have given limited copyright

protection to designs that are "part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5663. The description in the House Report seems precisely applicable to plaintiff's belt buckles. Congress, however, did not enact that title. Perhaps Congress should have enacted Title II in order to protect such designs. But it is not the Court's role to fill in gaps in statutes that may exist, particularly when the omission is clearly deliberate, rather than inadvertent.[4/]

Since the Court has found that these belt buckles are not properly copyrightable, a determination of whether plaintiff satisfied the statutory notice requirements is unnecessary, but brief discussion will suffice.

The Winchester Buckle probably satisfies the notice requirements under the 1909 Act. Although the notice is very small, it is legible to the naked eye -- at least that of someone with excellent vision. The fact that defendant did not copy the Winchester Buckle but instead allegedly bought unauthorized copies from a manufacturer without notice to defendant of the copyright does not affect the validity of the copyright or defendant's liability for infringement. If defendant has sold the unauthorized copies, which he admits, defendant's liability -- given a valid copyright -- is established. The infringer's claimed lack of

knowledge of the copyright[5] affects only damages, not basic liability and injunctive relief.

The Vaquero Buckle presents a different question under the notice requirements of the 1976 Act. The statute requires "reasonable notice," 17 U.S.C. § 401 (Supp. I 1977), which means legibility to the naked eye, as under the 1909 Act. 37 C.F.R. § 202.2(b)(8) (1979); 2 M. Nimmer, Nimmer on Copyright § 7.11[B] (1979). The copyright notice on the Vaquero Buckle, in the opinion of the Court, is not legible when viewed with the naked eye. The 1976 Act, however, includes a saving clause, which preserves the author's copyright despite publication without adequate notice,[6] provided that the claim of copyright is registered within five years of publication (which the plaintiff has done for the Vaquero Buckle) and provided that the copyright holder makes a reasonable effort to add adequate notice to all copies distributed to the public after notification of the omission.[7] 17 U.S.C. § 405 (Supp. I 1977). Once the notice requirement is satisfied -- given a valid copyright -- the copyright holder is entitled, at least, to injunctive relief against any infringer.

The Court finds that plaintiff's belt buckles do not fall in one of the specific categories of copyrightable subject matter already recognized in the statute, regulations, and case law and that they do not meet the test for copyrightability of

useful objects. The Court declines to expand those categories and that test to allow the inclusion of plaintiff's buckles within their boundaries. Thus, defendant's motion for summary judgment on the copyright claims is granted, and plaintiff's motion for summary judgment or a preliminary injunction is denied.

There being no just reason for delay, the Clerk is directed to enter judgment in accordance herewith pursuant to Fed. R. Civ. P. 54(b).[8/]

SO ORDERED:

Dated: New York, N.Y.,
April 30th, 1980.

Gerard L. Goettel

U.S.D.J.

FOOTNOTES: i

1/ The Court expresses no opinion as to the trademark infringement and unfair competition claims, since there has been no consideration of them thus far.

2/ The regulations provided:

> (a) General. This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture.
>
> (b) In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile material or textile product. The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been issued.
>
> (c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

24 Fed. Reg. 4958 (1959) (codified at 37 C.F.R. § 202.10).

3/ The definitional section of the 1976 Act provides:

> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. § 101 (Supp. I 1977).

4/ The limited copyright protection proposed in Title II, with a much shorter term than the copyright term of life of the author plus fifty years, seems more appropriate than traditional copyright for fashion design and other designs of useful articles.

5/ Some evidence was presented, moreover, that defendant was not an innocent infringer, since its president knew in May 1979 that the buckles were copies and even saw the copyright application in the fall of 1979.

6/ An illegible notice is equivalent to an omitted notice for purposes of both section 401 and section 405. 2 M. Nimmer, Nimmer on Copyright § 7.14[A] (1979).

7/ There is some doubt whether plaintiff has complied

with the second requirement of the saving clause. Since this decision does not turn on the notice issue, however, we need not make a final determination on it.

8/ The parties have stipulated to a temporary stay, for a period of up to 20 days from the date of this opinion, pending application to the Court of Appeals for a stay pending appeal.

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OFFICE OF THE
REGISTER OF COPYRIGHTS

SEP 13 1977

EDK:btd
9-8-77

Barry Kieselstein Ent. Inc.
67 Park Avenue
New York, New York 10016

Attention: Barry Cord SEP 15 1977

Re: WINCHESTER BUCKLE and LARGE VICTORIAN DOLL FACE RING WITH TEETH

Dear Mr. Cord:

The copyright statute requires that the "name of the copyright proprietor" be included as a part of the copyright notice. The purpose for this requirement, of course, is to apprise the public of the copyright proprietor's identity. A notice that does not do this is defective and will not support the registration of a claim to copyright.

The copyright notice on the copies of the work you submitted contains only the surname "Kieselstein-Cord." There is some doubt whether the presence of a surname alone in the copyright notice constitutes adequate compliance with the statute. However, in cases where the copies contain the name of no individual with the same surname that might mislead the public as to the identity of the copyright proprietor, registration is made in accordance with our practice of resolving doubtful cases in favor of registration wherever possible. In future works you should make certain the copyright notice contains the full name of the copyright proprietor on all published copies.

Sincerely yours,
Bernard C. Dietz
Head, Arts Section
Examining Division

By: EDK

Enclosure:
Circular R 99

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OFFICE OF THE
REGISTER OF COPYRIGHTS

SEP 13 1977

KDK:btd
9-8-77

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Sincerely yours,
Bernard C. Dietz
Head, Arts Section
Examining Division

By: KDK

Enclosure:
Circular R [illegible]

SHOULD BE NOT

REMITTER: Kieselstein (Barry) Ent. Inc.

Attention: Barry Cord

ADDRESS: 67 Park Ave
New York, N.Y. 10016

TITLE OF WORK: Winchester Buckle "and "Large Victorian Doll Face Ring With Teeth"
(give both titles)

CLASS: Gp

CASH NO.: 236620

DATE: 8/22/77

AM'T REC'D: 42.00

AM'T USED: 42.00

INFORMALITY:

- ☐ Excess Fee
- ☐ Misplaced Notice
- ☐ Dispersed Notice
- ☐ Change of Title
- ☐ Certificate(s) Ret'd
- ☐ Information Requested
- ☐ Incorrect Symbol in Notice
- ☒ surname in notice

RECOMMENDATION:

GL 155-A
in par 2: surname "Kieselstein-Cord"

Encl: circ. R99

EXAMINER: KDK

DATE: 8/31/77

REVISER:

DATE:

REC'D IN C. O.: 8/22/77

REC'D IN EXAM: 8/30/77

CROSS REFERENCES:

Form C-247
2/75 5,000

LC 3-120 (2/75)

Barry Kieselstein yes Barry Kieselstein

AUGUST 18,1977

MR. BERNARD C. DIETZ
HEAD, ARTS SECTION
EXAMINING DIVISION
LIBRARY OF CONGRESS
WASHINGTON,D.C. 20540

AUG 22 1977
42.00
236620 AUG 22 77

DEAR MR. DIETZ:

ENCLOSED PLEASE FIND SEVEN DIFFERNT APPLICATIONS FOR COPYRIGHT REGISTRATION APPLICATION. ALSO ENCLOSED IS A CHECK IN THE AMOUNT OF $42. FOR SAME. I WONDER IF YOUR OFFICE WOULD BE SO KIND AS TO SEND ME ANY OF THE LATEST MATERIAL REGARDING ANY OF THE CHANGES IN THE COPYRIGHT LAWS IN THE LAST 18MONTHS IF THERE WOULD BE A CHARGE FOR THESE WOULD YOU BE KIND ENOUGH TO BILL FOR SAME,I WOULD APPRECIATE THIS VERY MUCH.

SINCERELY,

BARRY CORD,
DIRECTOR BARRY KIESELSTEIN ENT.INC.

BC/jam

(7) qp 8/31/77 KDK

Cashier's Basket
Large Art Dallegio 11-11 [illegible]

Application
for Registration of a Claim to Copyright in a work of art or a model or design for a work of art

FORM G

REGISTRATION NO.
GP 119073
DO NOT WRITE HERE
GF GFO GP GU

CLASS G

Instructions: Make sure that all applicable spaces have been completed before you submit the form. The application must be **SIGNED** at line 11. For published works the application should not be submitted until after the date of publication given in line 6(a), and should state the facts which existed on that date. For further information, see page 4.

Pages 1 and 2 should be typewritten or printed with pen and ink. Pages 3 and 4 should contain exactly the same information as pages 1 and 2, but may be carbon copies.

Mail all pages of the application to the Register of Copyrights, Library of Congress, Washington, D.C. 20559, together with:

(a) If unpublished, a photograph or other identifying reproduction of the work and the registration fee of $6.

(b) If published, two copies of the best edition of the work (or if appropriate, photographs—see line 4) and the registration fee of $6.

Make your remittance payable to the Register of Copyrights.

1. Copyright Claimant(s) and Address(es): Give the name(s) and address(es) of the copyright owner(s). For published works the name(s) should ordinarily be the same as in the notice of copyright on the copies deposited. If initials are used in the notice, the name should be the same as appears elsewhere on the copies.

Name BARRY KIESELSTEIN-CORD *

Address 67 PARK AVENUE, NEW YORK 10016

Name

Address

2. Title: WINCHESTER BUCKLE
(Give the title of the work as it appears on the copies; a descriptive title may be used where the work is entirely pictorial or sculptural)

3. Nature of Work: SCULPTURE
(Characterize the general type of artistic work involved, as, for example, painting, drawing, sculpture, etc.)

NOTE: Leave line 4 blank unless the work has been PUBLISHED and photographs deposited in lieu of copies.

4. Optional Deposit: (See information on page 4.)

Basis for claiming option (Check and fill in **ONE** of the following):

☐ Monetary value (retail value per copy) ☐ Weight (in pounds)

☐ Size (give dimensions) ☐ Fragility (give details)

5. Author (i.e., Artist): Citizenship and domicile information must be given. Where a work is made for hire, the employer is the author. The citizenship of organizations formed under U.S. Federal or State law should be stated as U.S.A. If the copyright claim is based on new matter (see line 7) give information about the author of new matter.

Name BARRY KIESELSTEIN-CORD Citizenship U.S.A.
(Give legal name followed by pseudonym if latter appears on the copies) (Name of country)

Domiciled in U.S.A. Yes X No ____ Address 67 PARK AVENUE, NEW YORK 10016

NOTE: Leave all spaces of line 6 blank unless your work has been PUBLISHED.

6. (a) Date of Publication: Give the complete date when copies of this particular work were first placed on sale, sold, or publicly distributed. The date when copies were made or printed should not be confused with the date of publication. NOTE: The full date (month, day, and year) must be given.

SEPTEMBER 1 1976 **
(Month) (Day) (Year)

(b) Place of Publication: Give the name of the country in which this particular work was first published.

U.S.A.

(c) Manufacture Outside United States by Lithographic or Photoengraving Process: If the copies of this work were manufactured outside the United States by lithographic or photoengraving process, give the name of the country of manufacture.

NOTE: Leave all spaces of line 7 blank unless the instructions below apply to your work.

7. Previous Registration or Publication: If a claim to copyright in any substantial part of this work was previously registered in the U.S. Copyright Office in unpublished form, or if a substantial part of the work was previously published anywhere, give requested information.

Was work previously registered? Yes ____ No ____ Date of registration ____ Registration number ____

Was work previously published? Yes ____ No ____ Date of publication ____ Registration number ____

Is there any substantial **NEW MATTER** in this version? Yes ____ No ____ If your answer is "Yes," give a brief general statement of the nature of the **NEW MATTER** in this version. (New matter may consist of compilation, abridgment, editorial revision, and the like, as well as additional artistic or graphic material.)

EXAMINER
EDK

Complete all applicable spaces on next page

8. If registration fee is to be charged to a deposit account established in the Copyright Office, gi

DNA

9. Name and address of person or organization to whom correspondence or refund, if any, should be sent:

Name KIESELSTEIN-CORD Address 67 PARK AVENUE, NEW YORK 10016

10. Send certificate to:

(Type or print name and address)

Name BARRY KIESELSTEIN-CORD

Address 67 PARK AVENUE
(Number and street)

NEW YORK (City) NEW YORK (State) 10016 (ZIP code)

11. Certification: (Application not acceptable unless signed)

I CERTIFY that the statements made by me in this application are correct to the best of my knowledge.

(Signature of copyright claimant or duly authorized agent)

Application Forms

Copies of the following forms will be supplied by the Copyright Office without charge upon request.

Class A Form A—Published book manufactured in the United States of America.

Class A or B
- Form A–B Foreign—Book or periodical manufactured outside the United States of America (except works subject to the ad interim provisions of the copyright law).
- Form A–B Ad Interim—Book or periodical in the English language manufactured and first published outside the United States of America.

Class B
- Form B—Periodical manufactured in the United States of America.
- Form BB—Contribution to a periodical manufactured in the United States of America.

Class C Form C—Lecture or similar production prepared for oral delivery.

Class D Form D—Dramatic or dramatico-musical composition.

Class E
- Form E—Musical composition the author of which is a citizen or domiciliary of the United States of America or which was first published in the United States of America.
- Form E Foreign—Musical composition the author of which is not a citizen or domiciliary of the United States of America and which was not first published in the United States of America.

Class F Form F—Map.

Class G Form G—Work of art or a model or design for a work of art.

Class H Form H—Reproduction of a work of art.

Class I Form I—Drawing or plastic work of a scientific or technical character.

Class J Form J—Photograph.

Class K
- Form K—Print or pictorial illustration.
- Form KK—Print or label used for an article of merchandise.

Class L or M Form L–M—Motion picture.

Class N Form N—Sound recording.

Form R—Renewal copyright.

Form U—Notice of use of musical composition on mechanical instruments.

FOR COPYRIGHT OFFICE USE ONLY		
Application received AUG 22 1977	Two copies received AUG 22 1977	Photographs or reproductions received
One copy or reproduction received	* IN NOTICE: KIESELSTEIN-CORD (Cert.)	
Fee received 236620 AUG 22 77	** Year date in notice: 1977 (Appl.)	
Renewal		

U. S. GOVERNMENT PRINTING OFFICE : 1973 O - 488-213

Date

ROUTING AND TRANSMITTAL SLIP

TO: (Name, office symbol, room number, building, Agency/Post)	Initials	Date
1. Ms Schrader		
2.		
3.		
4.		
5.		

GENERAL COUNSEL
OF COPYRIGHT
JUN - 1980
RECEIVED

	Action		File		Note and Return
	Approval		For Clearance		Per Conversation
	As Requested		For Correction		Prepare Reply
	Circulate		For Your Information		See Me
	Comment		Investigate		Signature
	Coordination		Justify		

REMARKS

Attached is a copy of the correspondence written in connection with the Winchester Buckle, one of the works in the Kiesel stein-Cord case. There was no correspondence in connection with the other work in the case, "Vaquero."

DO NOT use this form as a RECORD of approvals, concurrences, disposals, clearances, and similar actions

FROM: (Name, org. symbol, Agency/Post)	Room No.—Bldg.
RSD 6/4/80	Phone No.

Dick,

Thanks. Please have a file prepared, including copy of appl, correspondence, and court opinion. Then please return to Records Mgmt.

DS

80-7354

United States Court of Appeals

FOR THE SECOND CIRCUIT

BARRY KIESELSTEIN-CORD,

Plaintiff-Appellant,

vs.

ACCESSORIES BY PEARL, INC.,

Defendant-Appellee.

PETITION FOR REHEARING IN BANC

DARBY & DARBY P.C.

WILLIAM F. DUDINE, JR.
DAVID R. FRANCESCANI
405 Lexington Avenue
New York, New York 10174
(212) 697-7660
Attorneys for Defendant-Appellee

Dated: October 2, 1980

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UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

BARRY KIESELSTEIN-CORD, Plaintiff-Appellant,	
	Docket No. 80-7354
ACCESSORIES BY PEARL, INC., Defendant-Appellee.	

PETITION FOR REHEARING IN BANC

Introduction

Defendant-Appellee respectfully petitions this Court for a rehearing in banc of its decision of September 18, 1980 in this action. This decision reversed the grant of summary judgment below that plaintiff's belt buckles were uncopyrightable for lack of separably identified and independently existing artistic features.[1/]

In an opinion by Circuit Judge Oakes, joined by Circuit Judge Van Graafeiland, this Court held:

> "This case is on a razor's edge of copyright law. It involves belt buckles, utilitarian objects which as such are not copyrightable." (Emphasis added)

1/ The decision of this Court is annexed hereto as Appendix A. The decision of the District Court (J. Goettel) is annexed as Appendix B.

Nothwithstanding this fact, the buckles were found copyrightable, because the majority saw sculptural features in the buckles which are "conceptually separable" from the utilitarian elements of the buckles.

The majority's "conceptually separable" holding marks a significant departure from well-established precedents of this and all other Courts of Appeal. It is at variance with the express intent of Congress and will extend copyright protection to utilitarian objects never before considered to be copyrightable. Rehearing in banc is thus appropriate because of the importance of the decision and the extraordinary impact it poses on the future protection of all commercial and industrial designs.

In dissent, Chief Judge Weinstein of the Eastern District of New York stated:

> "The works sued on are, while admirable aesthetically pleasing examples of modern design, indubitably belt buckles and nothing else; their innovations of form are inseparable 2/ from the important function they

2/ The 1976 Copyright Act restricts copyright protection on useful articles (such as the belt buckles herein) to "sculptural features that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article." (17 U.S.C. §101). The Act narrowed the pre-existing sweep of copyrightability by defining a useful article as one with "an intrinsic utilitarian function" (17 U.S.C. §101), instead of one (in the words of the old regulations) with utility as its "sole intrinsic function" (majority emphasis) (App'x A, 5718). Thus, the fact that a useful article also has an ornamental function, (indeed even as its primary function) does not remove that article from the "useful article" category of the Act. The distinction drawn by the Act is between such "useful articles" and articles whose "function... is... merely to portray the appearance of the article," such as jewelry - a distinction apparently not considered by the majority (Cf. App'x A, 5721).

> serve - helping to keep the tops of trousers at waist level." (App'x A, 5722)

Copyrightability does not turn on whether a utilitarian design is sculpted, whether it is cast in precious metals, or whether it is also used for ornamentation (fn.2, supra). It turns on the dual "identified separately/ independently existing" criteria. Both parts must be met.

The proposed Title II of the 1976 Act would have provided limited copyright protection on commercial designs such as the buckles herein. The Justice Department successfuly opposed enactment of Title II on the basis that:

> "We believe that design patents, as are granted today are as far as the public should go...
>
> ...the desirable free use of designs which do not rise to patentable invention of ornamental designs of useful articles are [sic] believed to be paramount.
>
> If the contribution made to the public by the creation of an ornamental design of a useful article is insufficient to rise to patentable novelty, the design should not be protected by the (copyright) law. The Department of Justice has consistently opposed legislation of this character." 3/

In view of the fact that Congress has consistently refused (and still refuses) to enact commercial design protection legislation, the dissent concludes that affirmance is required because,

> "... it is not for this court to twist the law in order to achieve a result Congress has denied." (App'x A, p. 5722)

3/ The entire extract appears at App'x. A, pp. 5729-31.

POINT I

The Majority's "Conceptual Separability" Test Enlarges the Scope of Copyright Protection Beyond that Recognized in This and All Other Circuits.

The copyright grant of exclusivity (17 U.S.C. §106) is not insubstantial. In the case of a work by an individual author, the term runs for the life of the author plus 50 years [17 U.S.C. §302(a)]. In the case of a work for hire, the copyright term is 75 years from the year of first publication or 100 years from the year of its creation [17 U.S.C. §302(c)]. By contrast, design patents (which unlike copyrights are examined for novelty and nonobviousness) last only for 3-1/2, 7 or 14 years at the patentee's option (35 U.S.C. §173).

This Circuit has consistently refused to sustain copyrights as well as other claims of restraint against the copying of fashion designs. Cheney Bros. v. Doris Silk Corp., 35 F.2d 279 (2d Cir. 1929)[4/] (silk designs not copyrightable);

4/ In Cheney, Judge Learned Hand recognized that "plaintiff had suffered a grievance for which there should be a remedy, perhaps by amendment of the Copyright Law" but said there were "larger issues at stake", i.e.,

> "Judges have only a limited power to amend the law; when the subject has been confided to a legislature, they must stand aside, even though there be an hiatus in completed justice.
>
> ....Congress might see its way to create some sort of temporary right, or it might not... it is not for us to decide. Our vision is inevitably contracted, and the whole horizon may contain much which will compose a very different picture." (35 F.2d at p. 281)

Jack Adelman, Inc. v. Sonners & Gordon, Inc., 112 F.Supp. 187 (S.D. N.Y. 1934) (picture of a dress copyrightable, but dress itself not copyrightable); Millinery Creator's Guild, Inc. et al. v. Federal Trade Commission, 109 F.2d 175, (2d Cir.), aff'd. 312 U.S. 469 (1940) ("What passes in the trade for an original design of a hat or a dress cannot be patented or copyrighted. An 'original' creation is too slight a modification of a known idea to justify the grant by the Government of a monopoly ..." 109 F.2d at 177); Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co., 155 F.Supp.932 (S.D.NY 1957), aff'd. in part, rev'd. on other grounds, 260 F.2d 637 (2d Cir. 1958) (artistically designed non-representational watch bands not copyrightable); Societe Comptoir de L'Indus. v. Alexander's Dept. Stores, 190 F. Supp. 594 (S.D. N.Y.), aff'd., 299 F.2d 33 (1962) ("In the case of bar it is conceded that 'pirating' of the design is lawful and proper." 299 F.2d at p. 36); SCOA Industries, Inc. v. Famolare, Inc., 192 U.S.P.Q. 216 (S.D.N.Y. 1976) (wavy lines on soles of shoes not copyrightable).

Despite these precedents, and despite its own recognition that belt buckles are utilitarian objects "which as such are not copyrightable," the majority upheld copyrightability here on the basis that:

> "We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts

> of the body other than the waist. The primary ornamental aspect (Ref. fn.2, supra) of the ... buckles is conceptually separable from their subsidiary utilitarian function." (App'x A, p. 5720)

A. Meaning and Impact of "Conceptually Separable" Test

The meaning (and application) of the majority's "conceptually separable" test is unclear. It appears that this phrase refers merely to the ornamental appearance of the utilitarian article. But if we extend copyrightability to utilitarian articles simply because they have ornamental aspects, there will be no limit to the number and variety of utilitarian articles that can be copyrighted. Few, if any utilitarian articles are made without some ornamental aspects. Rarely if ever are these articles made aesthetically neutral; they are all made to attract the customer.

Under the majority test the Eames chair, Saarinen chair, and chairs by Cessca and Breuer could all be copyrighted. All of them have ornamental aspects separable from their utilitarian function. Likewise accessories such as hats, handbags, boots and belts would be copyrightable for their ornamental value. Auto body designs by Fisher and Ghia would also be entitled to copyright protection.

The potential impact is evident. Each design and each variation thereof would be copyrighted and thereby monopolized for nearly a century. The public would be denied access

to useful, low priced, competitive versions. Designers would enforce their copyright claims on the undefined (and indefinable) "conceptually separable" ornamental features in their designs. While Congress could conceivably enact such legislation, and it might survive a constitutional test, Congress has not yet done so.

We are not arguing that there should be no protection for the aesthetic features of utilitarian articles. Rather, we agree with the position of the Justice Department that was accepted by the Congress (p. 3, supra), i.e. to the extent that such articles satisfy design patent requirements (35 U.S.C., Chapt. 16), they may be patented. However, as for copyright protection on utilitarian articles, such protection must be limited to artistic features which can be "separately identified and are capable of existing independently" of their utilitarian aspects, i.e., as in Mazer v. Stein, 347 U.S. 201 (1953) where copyrightability inhered only the non-utilitarian statuettes which had been separately and independently copyrighted prior to their utilitarian incorporation into the subject lamp stands.

The "conceptually separable" test goes far beyond this heretofore limited reach of copyright protection on utilitarian articles.

POINT II

The Majority's "Conceptually Separable" Standard Conflicts with the Language and Legislative Intent of the 1976 Copyright Act. It Would Impose an Unworkable Test on Artists, the Public, and the Courts.

In upholding copyrightability on the ground of "conceptual separability", the majority contradicts the plain meaning of the words of the Act.

> "...unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning." Diamond v. Chakrabarty, U.S. , 65 L.Ed.2d 144,149 (1980).

The plain meaning of the phrase "can be identified separately from, and are capable of existing independently of..." is that sculptural artistic features (if any) must first be established as separate identities or samenesses, and these identities or samenesses must then also be capable of existing or being independent (apart or aside) from the buckles as a whole. Again, the Mazer decision, supra, exemplifies the meaning. As held by the Fourth Circuit Court of Appeals:

> "The important fact, which must not be overlooked in analyzing Mazer, is that the Supreme Court in that case was dealing with a statuette, which though incorporated in a commercial article, was capable of existing independently and had itself been registered as a separate 'work of art' under §5(g). And it was that type of 'applied art' which the court found copyrightable under Mazer. Eltra Corp. v. Ringer, 579 F.2d 294,297 (4th Cir. 1978)

The majority's conclusion that "conceptual separability" meets both the "identified separately" and "existing independently" requirements thus conflicts with the plain meaning of these phrases. Separable identification and independent existence cannot be premised on the mere conceptualization of the viewer. To do so would destroy the objectivity, indeed the vitality, of the statutory test. The test would have no meaning.

The legislative history of the Act also demonstrates that "conceptual separability" cannot serve as the basis for copyrightability. This point was made clear in Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C.Cir. 1978), cert. denied, 440 U.S. 908 (1979). There (as here) the plaintiff claimed copyrightability on the basis of the same "physically or conceptually" excerpt relied on by the majority herein (App'x A, 5719). The Esquire Court rejected the argument:

> "This excerpt is not entirely free from ambiguity. Esquire could arguably draw some support from the statement that a protectable element of a utilitarian article must be separable "physically or conceptually" from the utilitarian aspects of the design. But any possible ambiguity raised by this isolated reference disappears when the excerpt 5/ is considered in its entirety.

5/ The referenced excerpt is reproduced in full in Judge Weinstein's dissent, App'x A, pp.5727-8.

> The underscored passages indicate unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright. (591 F.2d at 803-4)

Instead of dealing with this holding in Esquire, the majority refers (App'x A, 5719) to the concurring decision by Judge Leventhal which dealt primarily with the mandamus procedure there used. However, Judge Leventhal's opinion concurred fully with the above holding:

> "Esquire contends...the prohibition on registration (is) inapplicable where an article possesses from the outset not only utility but an aesthetically original and pleasing design form. I join in the rejection of that contention." 591 F.2d at 807.

The majority's "conceptually separable" test also conflicts with the premise that copyright protects the expression of the idea rather than the idea itself. This has now been codified in the 1976 Act as follows:

> "In no case does copyright protection for an original work of authorship extend to any idea ...regardless of the form in which it is described, explained, illustrated, or embodied in such work." [17 U.S.C. Sec. 102(b)]

Thus copyrightability cannot inhere in the "conceptual" separation of an artistic element; such a conceptualization is the antithesis of the expression of that element as the basis for the copyright grant.

POINT III

The Majority Opinion Conflicts with the Decisions of the D.C. Circuit and Fourth Circuit Courts of Appeals

In holding that "conceptually separable" artistic features may serve as the basis for copyrightability of useful articles, the majority is in direct conflict with the holding of both the District of Columbia and the Fourth Circuit Courts of Appeals.

In Esquire, Inc., v. Ringer, supra, The District of Columbia Circuit Court of Appeals expressly rejected the argument that the "physically or conceptually separable" excerpt from the House Report on the 1976 Act warranted copyrightability on the basis of conceptually separable artistic features (Ref. p.9, supra). The majority decision herein has not addressed this conflict.

The majority refers to "examples of conceptual separateness as an artistic notion (which) may be found in many museums", citing the Nimmer on Copyrights (pp.2-93,94), reference to Christo's "Running Fence" as an example of today's conceptual art. But Nimmer was not citing the "Running Fence" as an example of a copyrightable work of art. Nimmer at that point in his treatise was simply arguing that separability "may occur either 'physically or conceptually'". Nevertheless, Nimmer concedes that the Esquire decision is contra. (Nimmer, p. 2-93, fn. 112).

The majority opinion is also in conflict with the decision by the Fourth Circuit Court of Appeals in Eltra v. Ringer, supra. In that decision the Court held uncopyrightable a typeface design, stating:

> "This ["identified separately/existing independently"] amended Regulation spelt out a plain distinction and sought to draw a precise line between copyrightable works of applied art and uncopyrighted works of industrial design, as declared in Mazer. And the distinction as expressed in the Regulation, clearly accorded with Congressional intent and understanding, which, after all, is the controlling factor in statutory construction, as demonstrated by the long acquiescence of Congress in the Regulation. That this is so is clear from the exhaustive House Report 6/ on the 1976 revision of the Copyright Act, wherein the language of Regulation 202.10(c) is quoted and declared to be the prope construction of the phrase 'works of art' as used in §5(g)." 579 F.2d at p.297 (Emphasis added)

It is not seen how "conceptual separability" can be used to "draw a precise line" between copyrightable and uncopyrightable works.

6/ Quoting the same extract relied upon in the dissent herein (App'x A, 5727-8).

POINT IV

The Importance of the Issue Warrants In Banc Review

The majority decision breaks new ground in the copyright law. Copyright protection is now extended to a whole class of utilitarian articles which heretofore had been excluded from such protection. The extended term of the copyright grant (75 to 100 years) will make copyright protection the preferred form of protection. Since the "novelty" requirements of patent law do not apply to copyright law, the copyright monopoly will inevitably be extended to innumerable variations of common utilitarian items.

Congress has been struggling with legislation for design protection for over 50 years and has not yet reached a solution. This Court's decision steps into the breach on the basis of an appeal from a summary judgment. The issue here is no less important than that which was reviewed in banc by this Court in L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir. 1976), cert. denied 429 U.S. 857 (1976).

Any doubt this Court may have about the impact of its decision should be dispelled by the media comment regarding the case. Attached hereto as Appendix A are articles which have appeared in Women's Wear Daily, Daily News Record, Retail Weekly and The New York Times. The case has also been reported

on the metropolitan television channels. The reason for the extended news coverage of this decision is obvious - the potential impact on the public and the garment industry is substantial.

The dissent recognizes that important policies are at stake involving the question of whether artists should be encouraged by increasing their compensation, or whether cheap reproductions should be permitted for the less affluent. However, echoing the language of Judge Learned Hand, fn. 4, supra, the dissent concludes:

> "Thus far Congress and the Supreme Court have answered in favor of commerce and the masses rather than the artists, designers and the well-to-do. Any change must be left to those higher authorities. The choices are legislative not judicial." (App'x A, 5733)

We agree and therefore urge this Court to grant rehearing in banc.

Respectfully submitted,

DARBY & DARBY P.C.

Dated: October 2, 1980

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APPENDIX A

Second Circuit Slip Opinion
No. 1351, pp. 5711 - 5733

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 1351—September Term, 1979

(Argued June 19, 1980 Decided September 18, 1980)

Docket No. 80-7354

BARRY KIESELSTEIN-CORD,

Plaintiff-Appellant,

v.

ACCESSORIES BY PEARL, INC.,

Defendant-Appellee.

B e f o r e :

OAKES and VAN GRAAFEILAND, *Circuit Judges,*
and WEINSTEIN, *District Judge.**

Appeal from a grant of summary judgment on copyright infringement claims in favor of defendant-appellee in the United States District Court for the Southern District of New York, Gerard L. Goettel,

* Of the Eastern District of New York, sitting by designation.

Judge, holding that two belt buckles designed by plaintiff-appellant may not be copyrighted under federal copyright laws and regulations.

Reversed and remanded for further proceedings.

JANET P. KANE (Ronald J. Levine, Phillips, Nizer, Benjamin, Krim & Ballon, New York, New York, on the brief), *for Plaintiff-Appellant.*

WILLIAM F. DUDINE, JR. (David R. Francescani, Darby & Darby P.C., New York, New York, on the brief), *for Defendant-Appellee.*

CHARLES R. REEVES, JOHN C. MCNETT, C. DAVID EMHARDT, Woodard, Weikart, Emhardt & Naughton, Indianapolis, Indiana, *for LaVenta Corporation d/b/a Indiana Metal Craft* as Amicus Curiae.

OAKES, *Circuit Judge:*

This case is on a razor's edge of copyright law. It involves belt buckles, utilitarian objects which as such are not copyrightable. But these are not ordinary buckles; they are sculptured designs cast in precious metals—decorative in nature and used as jewelry is, principally for ornamentation. We say "on a razor's edge" because the case requires us to draw a fine line under applicable copyright law and regulations. Drawing the line in favor of the appellant designer, we

uphold the copyrights granted to him by the Copyright Office and reverse the district court's grant of summary judgment in favor of the appellee, the copier of appellant's designs.

FACTS

Appellant Barry Kieselstein-Cord designs, manufactures exclusively by handcraftsmanship, and sells fashion accessories. To produce the two buckles in issue here, the "Winchester" and the "Vaquero," he worked from original renderings which he had conceived and sketched. He then carved by hand a waxen prototype of each of the works from which molds were made for casting the objects in gold and silver. Difficult to describe, the buckles are solid sculptured designs, in the words of district court Judge Goettel, "with rounded corners, a sculpted surface, . . . a rectangular cut-out at one end for the belt attachment," and "several surface levels." The Vaquero gives the appearance of two curved grooves running diagonally across one corner of a modified rectangle and a third groove running across the opposite corner. On the Winchester buckle two parallel grooves cut horizontally across the center of a more tapered form, making a curving ridge which is completed by the tongue of the buckle. A smaller single curved groove flows diagonally across the corner above the tongue.

The Vaquero buckle, created in 1978, was part of a series of works that the designer testified was inspired by a book on design of the art nouveau school and the subsequent viewing of related architecture on a trip to Spain. The buckle was registered with the Copyright Office by appellant's counsel on March 3, 1980, with a publication date of June 1, 1978, as "jewelry," although

the appellant's contribution was listed on the certificate as "original sculpture and design." Explaining why he named the earlier buckle design "Winchester," the designer said that he saw "in [his] mind's eye a correlation between the art nouveau period and the butt of an antique Winchester rifle" and then "pulled these elements together graphically." The registration, which is recorded on a form used for works of art, or models or designs for works of art, specifically describes the nature of the work as "sculpture."

The Winchester buckle in particular has had great success in the marketplace: more than 4,000 belts with Winchester buckles were sold from 1976 to early 1980, and in 1979 sales of the belts amounted to 95% of appellant's more than $300,000 in jewelry sales. A small women's size in silver with "double truncated triangle belt loops" sold, at the time this lawsuit commenced, at wholesale for $147.50 and a larger silver version for men sold at wholesale with loops for $662 and without loops for $465. Lighter-weight men's versions in silver wholesaled for $450 and $295, with and without loops respectively. The gold versions sold at wholesale from $1,200 to $6,000. A shortened version of the belt with the small Winchester buckle is sometimes worn around the neck or elsewhere on the body rather than around the waist. Sales of both buckles were made primarily in high fashion stores and jewelry stores, bringing recognition to appellant as a "designer." This recognition included a 1979 Coty American Fashion Critics' Award for his work in jewelry design as well as election in 1978 to the Council of Fashion Designers of America. Both the Winchester and the Vaquero buckles, donated by appellant after this lawsuit was commenced, have been accepted by the

Metropolitan Museum of Art for its permanent collection.

As the court below found, appellee's buckles "appear to be line-for-line copies but are made of common metal rather than" precious metal. Appellee admitted to copying the Vaquero and selling its imitations, and to selling copies of the Winchester. Indeed some of the order blanks of appellee's customers specifically referred to "Barry K Copy," "BK copy," and even "Barry Kieselstein Knock-off." Thus the only legal questions for the court below were whether the articles may be protected under the copyright statutes and, if so, whether the copyrights were adequate under the laws. Having found that the copyrights were invalid—the Winchester under the Copyright Act of 1909, and the Vaquero under the 1976 Act[1]—because they "fail[ed] to satisfy the test of separability and independent existence of the artistic features, which is required under both statutes," Judge Goettel did not go on to make a conclusive determination on the further question whether the notice requirements of the acts had been met by appellant. Instead, he found that the Winchester buckle "probably" satisfies the 1909 Act notice requirements, and he reserved the question whether, with respect to the Vaquero buckle, appellant met the notice requirements of the 1976 Act by way of a saving clause that preserves a copyright despite publication without adequate notice, 17 U.S.C § 405. We therefore only reach the question whether the buckles may be copyrighted.

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1 The Winchester buckle was registered before the January 1, 1978, effective date of the Copyright Act of 1976.

DISCUSSION

We commence our discussion by noting that no claim has been made that the appellant's work here in question lacks originality or creativity, elements necessary for copyrighting works of art. *See L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951); 1 *Nimmer on Copyright* §§ 2.01, 2.08[B] (1980). The thrust of appellee's argument, as well as of the court's decision below, is that appellant's buckles are not copyrightable because they are "useful articles" with no "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects" of the buckles. The 1976 copyright statute does not provide for the copyrighting of useful articles except to the extent that their designs incorporate artistic features that can be identified separately from the functional elements of the articles. *See* 17 U.S.C. §§ 101, 102.[2] With respect

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2 17 U.S.C. § 101 provides in relevant part:

> As used in this title, the following terms and their variant forms mean the following:
>
> * * * * *
>
> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.
>
> * * * * *

(footnote continued on next page)

to this question, the law adopts the language of the longstanding Copyright Office regulations, 37 C.F.R. § 202.10(c) (1977)[3] (revoked Jan. 5, 1978, 43 Fed. Reg. 965, 966 (1978)). The regulations in turn were adopted in the mid-1950's, under the 1909 Act, in an effort to implement the Supreme Court's decision in *Mazer v. Stein*, 347 U.S. 201 (1954). *See* H.R. Rep. No. 1476,

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A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article".

17 U.S.C. § 102 provides generally for copyright protection of "pictorial, graphic, and sculptural works."

3 37 C.F.R. § 202.10, *reprinted in* 4 *Nimmer on Copyright*, App. 11, at 11-13 to 11-14 (1980), provided as follows:

Works of Art (Class G)

(a) General[.] This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture. [Revoked Jan. 1, 1978, 43 Fed. Reg. 965, 966 (1978).]

(b) In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile material or textile product. The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been issued. [Current version at 37 C.F.R. § 202.10(b) (1979).]

(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration. [Revoked Jan. 1, 1978, 43 Fed. Reg. 965, 966 (1978).]

94th Cong., 2d Sess. 54-55 (1976), *reprinted in* [1976] U.S. Code Cong & Ad. News 5659, 5668 [hereinafter cited as *House Report*]. The Court in *Mazer*, it will be recalled, upheld the validity of copyrights obtained for statuettes of male and female dancing figures despite the fact that they were intended for use and used as bases for table lamps, with electric wiring, sockets, and lampshades attached. *Mazer* itself followed a "contemporaneous and long-continued construction" by the Copyright Office of the 1870 and 1874 Acts as well as of the 1909 Act, under which the case was decided. 347 U.S. at 211-13. As Professor Nimmer points out, however, the Copyright Office's regulations in the mid-1950's that purported to "implement" this decision actually limited the Court's apparent open-ended extension of copyright protection to all aesthetically pleasing useful articles. *See* 1 Nimmer, *supra*, § 2.08[B], at 2-88 to 2-89.

Ultimately, as Professor Nimmer concludes, none of the authorities—the *Mazer* opinion, the old regulations, or the statute—offer any "ready answer to the line-drawing problem inherent in delineating the extent of copyright protection available for works of applied art." *Id.* at 2-89. Congress in the 1976 Act may have somewhat narrowed the sweep of the former regulations by defining a "useful article" as one with "*an* intrinsic utilitarian function," 17 U.S.C. § 101 (emphasis added), instead of one, in the words of the old regulations, with utility as its "*sole* intrinsic function," 37 C.F.R. § 202.10(c) (1977) (revoked Jan. 5, 1978, 43 Fed. Reg. 965, 966 (1978)) (emphasis added).

We are left nevertheless with the problem of determining when a pictorial, graphic, or sculptural feature "can be identified separately from, and [is]

capable of existing independently of, the utilitarian aspects of the article," 17 U.S.C. § 101. This problem is particularly difficult because, according to the legislative history explored by the court below, such separability may occur either "physically or conceptually," *House Report* at 55, [1976] U.S. Code Cong. & Ad. News at 5668. As the late Judge Harold Leventhal observed in his concurrence in *Esquire, Inc. v. Ringer*, 591 F.2d 796, 807 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), legislative policy supports the Copyright Office's "effort to distinguish between the instances where the aesthetic element is conceptually severable and the instances where the aesthetic element is inextricably interwoven with the utilitarian aspect of the article."[4] Examples of conceptual separateness as an artistic notion may be found in many museums today and even in the great outdoors. Professor Nimmer cites Christ's "Running Fence" as an example of today's "conceptual art": it "did not contain sculptural features that were physically separable from the utilitarian aspects of the fence, but the whole point of the work was that the artistic aspects of the work were conceptually separable." 1 Nimmer, *supra*, § 2.08[B] at 2-94.

Appellee argues that the belt buckles are merely useful objects, which include decorative features that serve an aesthetic as well as a utilitarian purpose. And the copyright laws, appellee points out, were never intended to nor would the Constitution permit them to

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[4] The court of appeals in the *Esquire* case reversed Judge Gesell's finding of conceptual separateness in the overall artistic design of an outdoor lighting fixture, 414 F. Supp. 939 (D.D.C. 1976). *See* 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

protect monopolies on useful articles. But appellee goes too far by further arguing that "copyrightability cannot adhere in the 'conceptual' separation of an artistic element." Brief for Defendant-Appellee at 17. This assertion flies in the face of the legislative intent as expressed in the House Report, which specifically refers to elements that "physically or conceptually, can be identified as separable from the utilitarian aspects of" a useful article. *House Report* at 55, [1976] U.S. Code Cong. & Ad. News at 5668.

We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist. The primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function. This conclusion is not at variance with the expressed congressional intent to distinguish copyrightable applied art and uncopyrightable industrial design, *House Report* at 55, [1976] U.S. Code Cong. & Ad. News at 5668. Pieces of applied art, these buckles may be considered jewelry, the form of which is subject to copyright protection, *Boucher v. Du Boyes, Inc.*, 253 F.2d 948, 949 (2d Cir.), *cert. denied*, 357 U.S. 936 (1958); *Cynthia Designs, Inc. v. Robert Zentall, Inc.*, 416 F. Supp. 510, 511-12 (S.D.N.Y. 1976); *Trifari, Krussman & Fishel, Inc. v. Charel Co.*, 134 F. Supp. 551, 552-53 (S.D.N.Y. 1955).[5]

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5 These cases were decided under the old Copyright Act of 1909, which protected "all the writings of an author," 17 U.S.C. § 4 (1976), and which included as one of the classes to which copyrighted work might belong "works of art; models or designs for works of art," *id.* § 5. Regulations promulgated under the 1909 Act listed "artistic jewelry" as an example of "works of art." 37 C.F.R. § 202.10(a) (1977), see note 3 *supra*.

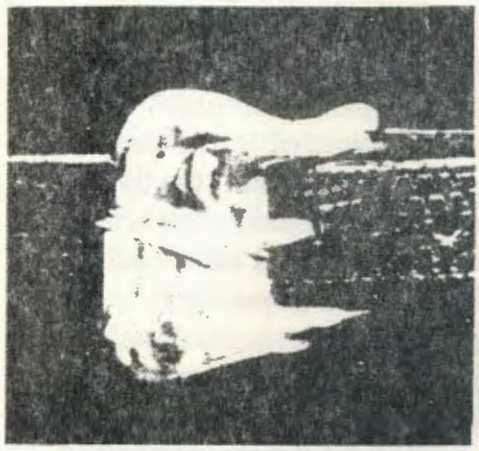
(footnote continued on next page)

Appellant's designs are not, as the appellee suggests in an affidavit, mere variations of "the well-known western buckle." As both the expert witnesses for appellant testified and the Copyright Office's action implied, the buckles rise to the level of creative art. Indeed, body ornamentation has been an art form since the earliest days, as anyone who has seen the Tutankhamen or Scythian gold exhibits at the Metropolitan Museum will readily attest. The basic requirements of originality and creativity, which the two buckles satisfy and which all works of art must meet to be copyrighted, would take the vast majority of belt buckles wholly out of copyrightability. The Copyright Office continually engages in the drawing of lines between that which may be and that which may not be copyrighted. It will, so long as the statute remains in its present form, always be necessary to determine whether in a given case there is a physically or conceptually separable artistic sculpture or carving capable of existing independently as a work of art.

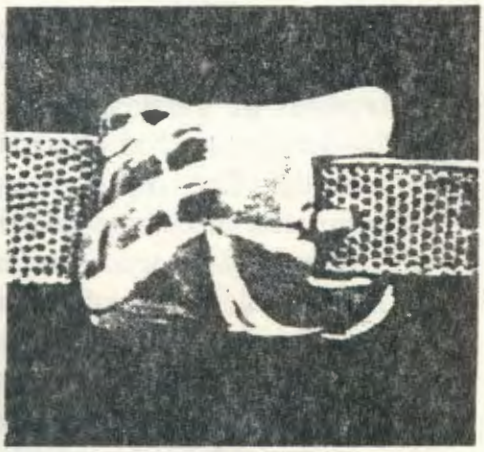
We reverse the grant of summary judgment to the appellee and remand the case for consideration of whether appellant has satisfied the copyright notice requirements.

The current statute extends copyright protection to "pictorial, graphic, and sculptural works," 17 U.S.C. § 102(a)(5), and notes that, in the words of the old regulation, 37 C.F.R. § 202.10(a) (1977), see note 3 *supra*, "[s]uch works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." 17 U.S.C. § 101, see note 2 *supra*. The new statute, while incorporating this regulatory definition, omits the specific examples, such as "artistic jewelry," listed in the old regulations. This omission does not suggest that jewelry may not be copyrighted. In fact, the explicit congressional adoption of the Copyright Office's definition indicates that jewelry remains within the scope of copyright protection.

with each of its sides of equal width, and a narrow tongue attached to one side—into a four sided structure with sides of unequal thickness and the usual narrow tongue. The artist has enhanced the appearance of the buckles by rendering their shape aesthetically pleasing without interfering with function. It is the originator's success in completely integrating the artistic designs and the functional aspects of the buckles that preclude copyright.



Winchester



Vaquero

The 1976 Copyright Act protects only those portions of useful articles, such as belt buckles, consisting of "sculptural features that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article." In relevant portions, the copyright law, title 17 of the United States Code, reads:

§ 101. Definitions

* * * * *

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; *the design of a useful article,* as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, *and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.*

* * * * *

A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. *An article that is normally a part of a useful article is considered a "useful article".*

§ 102. Subject matter of copyright: In general.

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. *Works of authorship* include the following categories:

* * * * *

(5) *pictorial, graphic, and sculptural works;*

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

(Emphasis supplied.)

The statute follows the decision of the Supreme Court in *Mazer v. Stein,* 34 U.S. 20, 74 S.Ct. 460, *rehearing denied,* 347 U.S. 949, 74 S.Ct. 637 (1954). In *Mazer,* the Court held that independent works of art may be copyrighted even if they are incorporated into useful articles—"nothing in the copyright statute . . . support[s] the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration." *Id.* at 218, 74 S.Ct. at 471. But the copyright protection covered only that aspect of the article that was a separately identifiable work of art independent of the useful article, in that instance a statuette used as part of a lamp.

Among recent decisions making this same distinction is *Esquire v. Ringer,* 591 F.2d 796 (D.C. Cir.), *cert. denied,* 440 U.S. 908, 99 S.Ct. 1217, *rehearing denied,* 441 U.S. 917, 99 S.Ct. 2019 (1979). *Esquire* denied copyright protection to the overall shape of a lighting fixture because of its integration of the functional aspects of the entire lighting assembly. The "overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright." *Id.* at 804.

While the distinction is not precise, the courts, both before and after *Mazer,* have tried to follow the

principle of the copyright act permitting copyright to extend only to ornamental or superfluous designs contained within useful objects while denying it to artistically designed functional components of useful objects. Generally they have favored representational art as opposed to non-representation artistic forms which are embodied in, and part of the structure of, a useful article. *Compare, e.g., Ted Arnold Ltd. v. Silvercraft Co.,* 259 F.Supp. 733 (S.D.N.Y. 1966) (antique telephone used to encase a pencil sharpener copyrightable); *Royalty Designs Inc. v. Thrifticheck Service Corp.,* 204 F.Supp. 702 (S.D.N.Y. 1962) (toy banks in shape of dogs copyrightable); *Scarves by Vera, Inc. v. United Merchants and Mfrs., Inc.,* 173 F.Supp. 625 (S.D.N.Y. 1959) (designs printed upon scarves copyrightable); *Syracuse China Corp. v. Stanley Roberts, Inc.,* 180 F.Supp. 527 (S.D.N.Y. 1960) (designs on dinnerware copyrightable) *with Esquire v. Ringer,* 591 F.2d 796 (D.C. Cir.), *cert. denied,* 440 U.S. 908, *rehearing denied,* 441 U.S. 917 (1979) (copyright denied to overall design of lighting fixture); *SCOA Industries, Inc. v. Famulare, Inc.,* 192 U.S.P.Q. 216 (S.D.N.Y. 1976) (wavy lines on soles of shoes not copyrightable); *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.,* 155 F.Supp. 932 (S.D.N.Y. 1957), *affirmed in part, reversed on other grounds,* 260 F.2d 637 (2d Cir. 1958) (artistically designed non-representational watchface not copyrightable); *Russell v. Trimfit, Inc.,* 428 F.Supp. 91 (E.D. Pa. 1977), *affirmed* 568 F.2d 770 (3d Cir. 1978) (designs of "toe socks" not copyrightable); *Jack Adelman, Inc. v. Sommers & Gordon, Inc.,* 112 F.Supp. 187 (S.D.N.Y. 1934) (picture of a dress may be copyrighted but the dress itself may not be). The relative certainty that has developed in

this area of the law should not be disturbed absent some compelling developments—and none have thus far been presented.

Interpretation and application of the copyright statute is facilitated by House Report No. 94-1476, by the Committee on the Judiciary. It explicitly indicated that the rule of *Mazer* was incorporated.

> In accordance with the Supreme Court's decision in *Mazer v. Stein,* 347 U.S. 201 (1954), works of "applied art" encompass all original pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection. . . .
>
> The Committee has added language to the definition of "pictorial, graphic, and sculptural works" in an effort to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection. The declaration that "pictorial, graphic, and sculptural works" include "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned" is classic language: it is drawn from Copyright Office regulations promulgated in the 1940's and expressly endorsed by the Supreme Court in the *Mazer* case.
>
> * * * * *
>
> In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and

uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, *although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill.* Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually can be identified as separable from the utilitarian aspects of that article" does not depend upon the nature of the design—that is, even if the appearance of an article is determined by aesthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. *And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the overall configuration of the utilitarian article as such.*

1976 U.S. Code Cong. & Admin. News, 5667-5668. (Emphasis supplied.)

Congress considered and declined to enact legislation that would have extended copyright protection to "[t]he

'design of a useful article' . . . including its two-dimensional or three-dimensional features of shape and surface, which make up the appearance of the article." H.R. 2223, Title II, § 201(b)(2), 94th Cong., 1st Sess. (January 28, 1975). Passage of this provision was recommended by the Register of Copyrights, Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary (Oct. 30, 1975) (testimony of Barbara Ringer), Reprinted in 16 Omnibus Copyright Revision Legislative History, 1855-59 (1975), and the United States Department of Commerce, Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary (May 8, 1975) (testimony and statement of Rene Tegtmeyer), Reprinted in 14 Omnibus Copyright Revision Legislative History, 161-162, 166-169. It was opposed by the Department of Justice on policy grounds. Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary (May 8, 1975) (testimony of Irwin Goldbloom), Reprinted in 14 Omnibus Copyright Revision Legislative History, 127-130, 139-141. The Justice Department noted the important substantive objections to the proposal—primarily it would charge the public a fee for the use of improved and pleasing new designs and styles in useful articles.

> Of particular concern to this Department is the new form of copyright protection provided by title II of the bill.
>
> This new form of protection is a hybrid between design patents, 35 U.S.C. 171-173, issued for a

period of up to 14 years by the Patent Office for new, original and ornamental designs of articles of manufacture and the copyright laws which provide for registration and issuance of certificates of copyrights for the writings of authors. The new protection that is provided under the bill is not presently available under the copyright laws and can only be obtained through a design patent after an examination procedure which determines whether the ornamental design meets the criteria of patentability, including unobviousness in view of the prior art, as provided by 35 U.S.C. 102, 103.

While the protection period as proposed for the new type of ornamental design protection is only a maximum of 10 years as compared with the maximum of 14 years available for a design patent, it is granted without the need of meeting the novelty and unobviousness requirements of the patent statute.

A threshold consideration before finding that the needs are such that this new type of protection should be available *is whether the benefits to the public of such protection outweigh the burdens. We believe that insufficient need has been shown to date to justify removing from the public domain and possible use by others of the rights and benefits proposed under the present bill for such ornamental designs.* We believe that design patents, as are granted today, are as far as the public should go to grant exclusive rights for ornamental designs of useful articles in the absence of an adequate showing that the new protection will provide substantial benefits to the general public

> which outweigh removing such designs from free public use.
>
> While it has been said that the examination procedure in the Patent Office results in serious delays in the issuance of a design patent so as to be a significant problem and damaging to "inventors" of ornamental designs of useful articles, *the desirable free use of designs which do not rise to patentable invention of ornamental designs of useful articles are believed* to be paramount.
>
> *If the contribution made to the public by the creation of an ornamental design of a useful article is insufficient to rise to patentable novelty, the design should not be protected by the law.* The Department of Justice has consistently opposed legislation of this character.
>
> To omit Federal statutory protection for the form of a useful object is not to deny the originator of that form any remedy whatsoever. If he can prove that competitors are passing their goods as the originator's by copying the product's design, he may bring an unfair competition action against such copyists.

Id. at 139-140 (Emphasis supplied.)

No additional testimony was received with respect to this aspect of the House bill. The Joint Senate-House Conference Committee deleted the design protection section to give further consideration to its administrative difficulties and to the benefits and burdens created by limiting the free public domain. 1976 U.S. Code Cong. & Admin. News, 5663, 5832. The attempt to gain protection was again mounted when Representative

Thomas F. Railsback introduced H.R. 4530 on June 19, 1979 to amend the Copyright Act of 1976. H.R. 4530's section 902 contains protections for the design of useful objects identical to those omitted from the 1976 Copyright Act. It was not adopted by Congress.

Interestingly, even if the design protection section proposed by the Department of Commerce and Representative Railsback had been passed, appellant's buckles might still have been excluded under the following subsection excluding three-dimensional features of apparel:

> DESIGNS NOT SUBJECT TO PROTECTION
>
> § 202. *Protection under this title shall not be available for a design that is—*
>
> * * * * *
>
> (e) *composed of three-dimensional features of shape and surface with respect to men's, women's and children's apparel,* including undergarments and outerwear.

(Emphasis supplied.) *See also* proposed § 202(b) (shape which has become common); § 202(c) (variants).

The distinctions between copyrightable "pictorial, graphic and sculptural works" and noncopyrightable industrial "designs" reflect serious concerns about the promotion of competition, the widespread availability of quality products and the advancement of technology through copying and modification. *See, e.g.,* G. Nelson, Design, 170 (1979) (experience suggests that free copying results in more rapid development); Comment, Copyright Protection for Mass Produced, Commercial Products: A Review of the Developments Following *Mazer v. Stein,* 38 U. Chi. L. Rev. 807, 819-22 (1971);

Note, Protection for the Artistic Aspects of Articles of Utility, 72 Harv. L. Rev. 1520, 1532-4 (1959). A similar need to balance societal interest in the availability of literary and dramatic works against the copyright holders' interest in their exclusive enjoyment is reflected in the fair use provisions of the Copyright Act of 1976. 17 U.S.C. §§ 107-112. *See also, e.g.,* Note, Copyright Infringement and the First Amendment, 79 Col. L. Rev. 320 (1979); Ramos, The Betamax Case: Accommodating Public Access and Economic Incentive in Copyright Law, 11 Intellectual Property L. Rev. 221, 230-1 (1979).

Important policies are obviously at stake. Should we encourage the artist and increase the compensation to the creative? Or should we allow cheap reproductions which will permit our less affluent to afford beautiful artifacts? Appellant sold the original for $600.00 and up. Defendant's version went for one-fiftieth of that sum.

Thus far Congress and the Supreme Court have answered in favor of commerce and the masses rather than the artists, designers and the well-to-do. Any change must be left to those higher authorities. The choices are legislative not judicial.

APPENDIX B

District Court Decision
Kieselstein-Cord v. Accessories by Pearl, Inc.
206 USPQ 439 (S.D. N.Y. 1980)

I. Ground VII: That Stockebrand withheld literature which described the most pertinent prior art known to himself or plaintiff in violation of the applicant's duty of disclosure.

[20] The decision cites numerous references in Stockebrand's depositions to literature existing in 1963 describing "LINC Tape", which the parties stipulated to be "the most pertinent prior art known to Stockebrand, DEC or DEC's attorneys." Because the information was not filed, nor disclosed in any way, and because the USPTO concluded that such information would clearly be material in addressing the requirements of 35 U.S.C. §103, the failure to disclose the information, as required by 37 CFR §1.56(a), provided grounds to strike the application.

On the basis of the evidence cited in the April 1978 decision to support the decision to strike Stockebrand's application for reissue, partly recounted above, I determine that the Commissioner's finding that there was clear and convincing evidence of fraud as prohibited by the Patent Act was not arbitrary and capricious nor an abuse of discretion and the decision, accordingly, stands. 5 U.S.C. §706(2).

In summary, because the action taken by the Commissioner was a correct application of a proper regulation which legally implemented a constitutionally satisfactory statute and was sufficiently supported by evidence in the record, plaintiff's motion for summary judgment is denied and defendants' motion for summary judgment is, as to all claims, allowed. Judgment may be entered for defendants.

District Court, S.D. New York

Kieselstein-Cord
v. Accessories By Pearl, Inc.

No. 80 Civ. 1029
Decided Apr. 30, 1980

COPYRIGHTS

1. In general (§24.01)

Jurisdiction of courts — Copyrights (§43.20)

Pleading and practice in courts — Burden of proof — In general (§53.131)

Registration by Copyright Office is prima facie evidence of copyrightability, as well as of information contained in registration certificate, under both Copyright Act of 1909 and Copyright Act of 1976; this presumption is not conclusive, but merely shifts burden of proof; despite this initial judicial deference to expertise of Copyright Office, its decisions are subject to review by courts.

2. Matter copyrightable — In general (§24.301)

Copyright Act of 1976 retains and enacts separability and independent existence requirement of 1959 copyright regulations.

3. In general (§24.01)

Matter copyrightable — In general (§24.301)

Copyrightability of article first issued on Sept. 1, 1976 must be considered under Copyright Act of 1909, regulations promulgated under it, and relevant case law; item first issued June 1, 1978 must be considered under Copyright Act of 1976 which became effective Jan. 1, 1978; tests of copyrightability under Copyright Act of 1909 and Copyright Act of 1976 appear to be virtually same, since 1976 Act essentially incorporates case law and regulations under 1909 Act.

4. Matter copyrightable — In general (§24.301)

Belt buckles that fail to satisfy test of separability and independent existence of artistic features, which is required under both 1909 and 1976 Copyright Acts, are uncopyrightable subject matter.

5. Matter copyrightable — In general (§24.301)

Legislative history of 1976 Copyright Act makes it clear that only separable artistic features of utilitarian objects are copyrightable, such as carving on back of chair, but not the chair, no matter how beautiful and originally designed.

6. Matter copyrightable — In general (§24.301)

Matter copyrightable — Classes in statute (§24.303)

Although it is possible to see belt buckles as jewelry, they are more appropriately categorized as utilitarian articles.

7. Matter copyrightable — In general (§24.301)

Matter copyrightable — Classes in statute (§24.303)

Matter copyrightable — Designs (§24.305)

Design superimposed on fabric is copyrightable, whereas style of dress, even

expensive Parisian couturier's design, in which fabric is used, is not, no matter how original, ornamental, or nonessential for function that design may be; fabric design can be seen as separable artistic element, whereas overall dress design, like overall shape of belt buckle, cannot.

8. In general (§24.01)

Matter copyrightable — In general (§24.301)

Copyright law is statutory, and congressional intent should be accorded great weight; wording of 1976 Copyright Act demonstrates Congress's concern with distinguishing separable artistic features of useful articles, which are copyrightable, from useful articles themselves, which are not copyrightable; Congress has demonstrated its intention that useful articles not be copyrightable by its rejection of copyright protection for original designs for consumer and industrial products.

9. Accounting — Damages — Copyrights (§11.253)

Infringement — In general (§24.201)

Notice of copyrights (§24.35)

Injunction — Copyrights (§40.3)

Notice that, while very small, is legible at least to naked eye of someone with excellent vision probably satisfies notice requirements under 1909 Copyright Act; fact that accused infringer did not copy copyright owner's product but instead bought unauthorized copies from other manufacturer without notice of copyright does not affect validity of copyright or accused's liability for infringement; accused's liability, given valid copyright, is established by sale of unauthorized copies; lack of knowledge of copyright affects only damages, not basic liability and injunctive relief.

10. Notice of copyright (§24.35)

Injunction — Copyrights (§40.3)

17 U.S.C. 401 requires "reasonable notice," which, as under 1909 Copyright Act means legibility to naked eye; illegible notice is equivalent to omitted notice for purposes of 17 U.S.C. 401 and 405; 1976 Copyright Act includes savings clause that preserves author's copyright despite publication without adequate notice, provided that claim of copyright is registered within five years of publication, and provided that copyright holder makes reasonable effort to add adequate notice to all copies distributed to public after notification of omission; copyright holder is at least entitled to injunctive relief against any infringer once notice requirement is satisfied.

Action by Barry Kieselstein-Cord, against Accessories By Pearl, Inc., for copyright infringement, trademark infringement, and unfair competition. On plaintiff's motion for preliminary injunction, and cross-motions for summary judgment on copyright claim. Defendant's motion for summary judgment granted.

Phillips, Nizer, Benjamin, Krim & Ballon, New York, N.Y. (Janet P. Kane and Ronald J. Levine, both of New York, N.Y., of counsel) for plaintiff.

Darby & Darby, P.C., New York, N.Y. (William F. Dudine, Jr., New York, N.Y., of counsel) for defendant.

Goettel, District Judge.

Plaintiff Barry Kieselstein-Cord is the designer of two belt buckles called the Winchester Buckle and the Vaquero Buckle, copies of which he alleges defendant Accessories By Pearl, Inc. has made, sold, distributed, and/or advertised. In this suit for copyright infringement, trademark infringement, and unfair competition, plaintiff has moved for a preliminary injunction and both parties have moved for summary judgment on the copyright claims. After evidentiary hearings on those motions, the Court denies plaintiff's motion for a preliminary injunction or summary judgment and grants defendant's motion for summary judgment.[1]

Plaintiff's buckles are both made of silver, or other precious metal. The Vaquero Buckle is roughly rectangular, with rounded corners, a sculpted surface, and a rectangular cut-out at one end for the belt attachment. It has several surface levels, giving the appearance of two grooves cut across one corner and another at the diagonally opposite corner. The Winchester Buckle is somewhat more irregularly shaped, also with a rectangular cut-out for the belt attachment. There is a tapered, wavy groove cut where the tongue of the buckle would fit and a smaller (almost imperceptible) separate level at a corner near the belt. Defendant's buckles appear to be line-for-line copies, but are made of common metal rather than silver.

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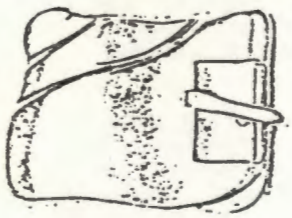
[1] The Court expresses no opinion as to the trademark infringement and unfair competition claims, since there has been no consideration of them thus far.



Plaintiff has registered a claim to copyright for each buckle: for the Winchester, Registration No. GP-119073, effective August 22, 1977; for the Vaquero, Registration No. VA-43-985, effective March 3, 1980 (after the commencement of this action). Defendant admits to copying and selling its copies of the Vaquero and to selling copies of the Winchester. Thus, on the questions of copyright infringement of the Vaquero Buckle and the Winchester Buckle, there remain only the legal issues of the validity of the copyrights and the adequacy of the notice under the copyright statutes.

During expedited discovery and the evidentiary hearings on the copyright claims, defendant has been restrained from continuing to sell or distribute the two buckles by a stipulation regarding the Winchester copies and a temporary restraining order regarding the Vaquero copies. The hearings on the copyright claims are complete, and, since there is "no genuine issue as to any material fact," Fed. R. Civ. P. 56(c), the Court is in a position to rule on the summary judgment motions. Hence, it is unnecessary to consider separately the motion for a preliminary injunction.

[1] The threshold question in determining if plaintiff has valid copyright in the Winchester Buckle and the Vaquero Buckle is whether these belt buckles are copyrightable subject matter. We begin with a presumption that these belt buckles are copyrightable, since the Copyright Office registered plaintiff's claims to copyright. Under both the Copyright Act of 1909 ("1909 Act") and the Copyright Act of 1976 ("1976 Act"), registration by the Copyright Office is prima facie evidence of copyrightability, as well as of the information contained in the registration certificate. 1909 Act, 17 U.S.C. §209 (1976) (repealed by 1976 Act); 1976 Act, 17 U.S.C. §410(c) (Supp. I 1977). This presumption is not conclusive, however; it merely shifts the burden of proof. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 157 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5773. Despite this initial judicial deference to the expertise of the Copyright Office, its decisions are subject to review by the courts. Bailie v. Fisher, 258 F.2d 425, 117 USPQ 334 (D.C. Cir. 1958).

Under the two statutes and the regulations promulgated thereunder, as well as under the relevant case law, the Winchester Buckle and the Vaquero Buckle are not copyrightable subject matter. Although plaintiff asserts that the buckles are jewelry or sculpture, they appear to be primarily belt buckles. Belt buckles are utilitarian objects designed to fasten belts and thus hold up or hold in a dress, skirt, or pants. Like most utilitarian objects, particularly those worn or carried on the person or used in the home, belt buckles may also be decorative.

A substantial body of law has developed on the subject of the copyrightability of utilitarian objects. Copyright protection was originally granted only to authors of maps, charts, and books and was not expanded to include three-dimensional works of art until 1870. Mazer v. Stein, 347 U.S. 201, 208-09, 100 USPQ 325, 329 (1954). Although the Copyright Office interpreted "works of art" broadly enough to include objects with utilitarian aspects, id. at 211-13, 100 USPQ at 330-332, some courts did not. Id. at 203, 100 USPQ at 327. The Supreme Court, in Mazer v. Stein, supra, settled the issue, holding that the use or intended use of statuettes of dancing figures, which were otherwise eligible for copyright, as bases for table lamps did not bar or invalidate their registration. The Court's reasoning involved two steps: first, the holding that the statuettes were independently copyrightable as works of art, id. at 214, 100 USPQ at 331-332; and second, the holding that their use as lamp bases did not destroy their copyrightability.

The regulations adopted by the Copyright Office in the mid-1950's and modified in 1959 were an attempt to retain and refine the Mazer distinction between the work of art and its incorporation in a useful object such as a lamp. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54-55 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5668. The regulations on works of art[2] permitted the copyrighting of "works

[2] The regulations provided:

of artistic craftsmanship" regardless of the "intention of the author as to the use of the work." 37 C.F.R. §202.10(a), (b). The regulations required, however, that the artistic features incorporated in the utilitarian object be separately identifiable and "capable of existing independently as a work of art." Id. §202.10(c).

The requirement of separability and capability of independent existence for the artistic features to be copyrighted was emphasized in the principal case that treats extensively the question of copyrightability of utilitarian objects. The court in Esquire, Inc. v. Ringer, 591 F.2d 796, 199 USPQ 1 (D.C. Cir. 1978), cert. denied, 440 U.S. 908, 201 USPQ 256 (1979), held that lighting fixtures designed with unusual elliptically shaped housings were not eligible for copyright protection as works of art because there were no separately identifiable artistic elements. The court noted that Congress, in its most recent pronouncement on the issue in considering the 1976 Act, unequivocally found ineligible for copyright "the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations." Id. at 804, 199 USPQ at 7.

[2] The 1976 Act further refined the test for copyrightability of useful articles. It defines the term as follows: "A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article'." 17 U.S.C. §101 (Supp. I 1977). In addition, the 1976 Act retains and enacts the separability and independent existence requirement of the 1959 regulations. See id.[1]

[3] The Winchester Buckle, which was first issued on September 1, 1976, must be considered under the 1909 Act, the regulations promulgated thereunder, and the relevant case law. The Vaquero Buckle was first issued on June 1, 1978, and thus must be considered under the 1976 Act, which became effective on January 1, 1978. The tests of copyrightability under the two acts appear to be virtually the same, however, since the 1976 Act essentially incorporates the case law and regulations under the 1909 Act.

[4] Both buckles are uncopyrightable subject matter under either statute because they fail to satisfy the test of separability and independent existence of the artistic features, which is required under both statutes. The Court does not see in these buckles "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of" the buckles. 17 U.S.C. §101 (Supp. I 1977); see 37 C.F.R. §210(c) (1977). Nor does plaintiff identify such features. Instead, the simple, sculptural form of the buckles seems to be very similar to the "overall design or configuration of a utilitarian object" that the Esquire court found uncopyrightable. 591 F.2d at 804, 199 USPQ at 7. As the Es-

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(a) General. This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture.

(b) In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile material or textile product. The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been issued.

(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

24 Fed. Reg. 4958 (1959) (codified at 37 C.F.R. §202.10).

[1] The definitional section of the 1976 Act provides:

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. §101 (Supp. I 1977).

quire court pointed out, the Supreme Court in Mazer dealt with a different sort of issue. Id. at 804-05, 199 USPQ at 7-8. In Mazer, the statuettes were clearly copyrightable subject matter capable of independent existence, and the only real question was whether their use as lamp bases *destroyed* their copyrightability. Here, each of the buckles is all one form, which, although pleasing, serves a utilitarian purpose. One cannot imagine the buckles or any part of them existing independently as sculpture in the way that the Mazer statuettes could exist.

[5] The cases plaintiff cites in support of the copyrightability of his belt buckles are distinguishable. Mazer, as we have noted, is distinguishable because the statuettes are capable of existing as works of art independent of the utilitarian objects into which they are incorporated. As the legislative history of the 1976 Act makes clear, only the separable artistic features of utilitarian objects are copyrightable, such as the carving on the back of a chair (but not the chair, no matter how beautifully and originally designed). H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5668.

[6] Cynthia Designs, Inc. v. Robert Zentall, Inc., 416 F.Supp. 510, 191 USPQ 35 (S.D.N.Y. 1976), and Boucher v. DuBoyes, Inc., 253 F.2d 948, 117 USPQ 156 (2d Cir.), cert. denied, 357 U.S. 936, 117 USPQ 497 (1958), are distinguishable because they concern jewelry, which has been expressly recognized under the regulations as a special category within the general category of works of art. 37 C.F.R. §202.10(a) (1977). See note 2 supra. Although it is possible to see belt buckles as jewelry under 37 C.F.R. §202.10(a), they are more appropriately categorized as utilitarian articles under 37 C.F.R. §202.10(c). Boucher is further distinguishable on the ground that it was decided before the refinement of the Mazer test in the 1959 regulations.

Syracuse China Corp. v. Stanley Roberts, Inc., 180 F.Supp. 527, 125 USPQ 62 (S.D.N.Y. 1960), and William A. Meier Glass Co. v. Anchor Hocking Glass Corp., 95 F.Supp. 264, 88 USPQ 249 (W.D. Pa. 1951), which plaintiff also cites in support of copyrightability, do concern useful objects, as the jewelry cases do not. The copyrights in these cases, however, were for the designs *on* plates and glassware, not for the plates and glassware themselves. These designs, thus, satisfy the separability requirement, whereas the buckle designs do not.

Dan Kasoff, Inc. v. Gresco Jewelry Co., 204 F.Supp. 694, 133 USPQ 438 (S.D.N.Y.), aff'd, 308 F.2d 806, 135 USPQ 209 (2d Cir. 1962), concerns a copyright on a small ornamental box. The court in Dan Kasoff discusses the issue of copyrightability very briefly, relying primarily on Mazer and making no mention of the test of separability. Since no description of the box is included, except that it was "ornamental" and had a "highly stylized cover," id. at 694, 133 USPQ at 438, it is difficult to say whether satisfaction of the separability requirement was an issue there as it is here.

Plaintiff argues that his belt buckles are so unusual and ornamental that they constitute sculpture. There no longer is anything remotely resembling a standard belt buckle. There are many thousands of different designs for buckles which are, to varying degrees, ornamental. Even if we agree with plaintiff that his designs are particularly pleasing, that does not exalt their status as belt buckles. Under plaintiff's approach, virtually every new design for a belt buckle could properly be copyrighted.

[7] The belt buckles in this case seem to belong more to the world of fashion design than to the world of literature and art, which is the traditional domain of copyright law. The status of designs for clothing is instructive. The design superimposed on a fabric is copyrightable, whereas the style of the dress (even an expensive Parisian couturier's design) in which the fabric is used is not — no matter how original, ornamental, or nonessential for function that design may be. 1 M. Nimmer, Nimmer on Copyright §2.08[H] (1979). The fabric design can be seen as a separable artistic element, whereas the overall dress design — like the overall shape of the belt buckle — cannot.

[8] Since copyright law is statutory, congressional intent should be accorded great weight. The wording of the 1976 Act demonstrates Congress's concern with distinguishing separable artistic features of useful articles, which are copyrightable, from useful articles themselves, which are not copyrightable. The House Report on the 1976 Act makes the distinction even more explicit:

> The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design — that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the

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useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5668. Finally, Congress has demonstrated its intention that useful articles not be copyrightable by its rejection — most recently in 1976 — of copyright protection for original designs for consumer and industrial products. See Esquire v. Ringer, supra, 591 F.2d at 800, 199 USPQ at 3-4. Proposed Title II of the 1976 Act would have given limited copyright protection to designs that are "part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50 (1976), reprinted in [1976] U.S. Code Cong. & Ad. News 5659, 5663. The description in the House Report seems precisely applicable to plaintiff's belt buckles. Congress, however, did not enact that title. Perhaps Congress should have enacted Title II in order to protect such designs. But it is not the Court's role to fill in gaps in statutes that may exist, particularly when the omission is clearly deliberate, rather than inadvertent.[4]

Since the Court has found that these belt buckles are not properly copyrightable, a determination of whether plaintiff satisfied the statutory notice requirements is unnecessary, but brief discussion will suffice.

[9] The Winchester Buckle probably satisfies the notice requirements under the 1909 Act. Although the notice is very small, it is legible to the naked eye — at least that of someone with excellent vision. The fact that defendant did not copy the Winchester Buckle but instead allegedly bought unauthorized copies from a manufacturer without notice to defendant of the copyright does not affect the validity of the copyright or defendant's liability for infringement. If defendant has sold the unauthorized copies, which he admits, defendant's liability — given a valid copyright — is established. The infringer's claimed lack of knowledge of the copyright[5] affects only damages, not basic liability and injunctive relief.

[10] The Vaquero Buckle presents a different question under the notice requirements of the 1976 Act. The statute requires "reasonable notice," 17 U.S.C. §401 (Supp. I 1977), which means legibility to the naked eye, as under the 1909 Act. 37 C.F.R. §202.2(b)(8) (1979); 2 M. Nimmer, Nimmer on Copyright §7.11[B] (1979). The copyright notice on the Vaquero Buckle, in the opinion of the Court, is not legible when viewed with the naked eye. The 1976 Act, however, includes a saving clause, which preserves the author's copyright despite publication without adequate notice,[6] provided that the claim of copyright is registered within five years of publication (which the plaintiff has done for the Vaquero Buckle) and provided that the copyright holder makes a reasonable effort to add adequate notice to all copies distributed to the public after notification of the omission.[7] 17 U.S.C. §405 (Supp. I 1977). Once the notice requirement is satisfied — given a valid copyright — the copyright holder is entitled, at least, to injunctive relief against any infringer.

The Court finds that plaintiff's belt buckles do not fall in one of the specific categories of copyrightable subject matter already recognized in the statute, regulations, and case law and that they do not meet the test for copyrightability of useful objects. The Court declines to expand those categories and that test to allow the inclusion of plaintiff's buckles within their boundaries. Thus, defendant's motion for summary judgment on the copyright claims is granted, and plaintiff's motion for summary judgment or a preliminary injunction is denied.

There being no just reason for delay, the Clerk is directed to enter judgment in accor-

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[4] The limited copyright protection proposed in Title II, with a much shorter term than the copyright term of life of the author plus fifty years, seems more appropriate than traditional copyright for fashion design and other designs of useful articles.

[5] Some evidence was presented, moreover, that defendant was not an innocent infringer, since its president knew in May 1979 that the buckles were copies and even saw the copyright application in the fall of 1979.

[6] An illegible notice is equivalent to an omitted notice for purposes of both section 401 and section 405. 2 M. Nimmer, Nimmer on Copyright §7.14[A] (1979).

[7] There is some doubt whether plaintiff has complied with the second requirement of the saving clause. Since this decision does not turn on the notice issue, however, we need not make a final determination on it.

dance herewith pursuant to Fed. R. Civ. P. 54(b)."

So Ordered.

Patent and Trademark Office
Board of Appeals

Ex parte MacAdams, Wu, and Joyner

Opinion dated Oct. 31, 1978
Patent No. 4,185,067 issued Jan. 22, 1980

PATENTS

1. Board of Appeals — Issues determined (§19.30)

Pleading and practice in Patent Office — Rules effect (§54.9)

Claims that are withdrawn from consideration under Patent Rule 142(b) are not before Board of Appeals.

2. Patentability — Anticipation — Combining references (§51.205)

Patentability — Change — Material (§51.257)

Patentability — Invention — In general (§51.501)

It is not proper to determine process' patentability solely on lack of novelty of physical manipulative steps; specific nature of material employed in process has bearing on process' patentability and, if its use in process is not obvious from art or is responsible for unexpected results, method "as a whole" must be considered unobvious; thus, distinction exists between method of making novel material by conventional process and method of using either novel material or old material whose use in claimed process would not have been obvious from art; in method of making material, novelty in resulting product does not impart patentability to otherwise conventional and well-known process, whereas in method of use, patentable novelty in material acted upon does impart patentability to such method even if method, per se, involves only conventional manipulation or technique.

3. Patentability — Composition of matter (§51.30)

Patentability — Invention — In general (§51.501)

Patentability — Invention — Specific cases — Chemical (§51.5093)

Statutory standard of Section 103 for determining obviousness of invention is whether in view of prior art invention "as a whole" would have been obvious at time it was made; obviousness of process cannot be determined by whether "given" the composition the claimed process of use would have been obvious; rather, obviousness of process using patentable material must be determined without reference to knowledge of it and its properties; thus, it follows from fact that prior art only shows use of "similar" composition in rotational molding, blend as recited in appealed claims being presumptively novel and patentable, that method of using such novel blend, albeit in conventional process, is patentable inasmuch as those skilled in art were not in possession of blend acted upon, and such blend, being unobvious, process of using it must, a fortiori, also be unobvious.

4. Patentability — Invention — In general (§51.501)

Holdings in In re Kuehl, 177 USPQ 250, and In re Mancy, 182 USPQ 303, were not predicated on fact that "active elements" were present in respective processes held to be unobvious.

5. Patentability — Anticipation — Process (§51.225)

Patentability — Invention — In general (§51.501)

Patentability — Invention — Specific cases — Chemical (§51.5093)

Reasoning based on notion that polymer being molded need not be treated as part of process "as a whole" and can be relegated to category of "prior art" since, presumably, only conventional physical manipulative steps are involved is contrary to law.

6. Double patenting — Process and product or apparatus (§33.7)

Joinder of invention — Process, product and apparatus (§42.5)

Claims drawn to method of using the patented compositions peculiarly adapted for claimed purpose of rotational molding and whose use would be so recognized by those skilled in art, as is apparent from secondary

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* The parties have stipulated to a temporary stay, for a period of up to 20 days from the date of this opinion, pending application to the Court of Appeals for a stay pending appeal.

APPENDIX C

N.Y. Times, March 11, 1980 - p. B15
Retail Week, May 15, 1980 - pp. 8-10
Women's Wear Daily, Sept. 23, 1980 - p. 15
Women's Wear Daily, Sept. 26, 1980 - p. 26
Daily News Record, Sept. 23, 1980 - p. 21

In Pursuit of the Jewelry Lookalikes

By ANNE-MARIE SCHIRO

Many designers take it for granted that their work will be copied. Barry Kieselstein-Cord is not one of them. The jewelry designer, who won a Special Coty Award last year, is suing three manufacturers for imitating two of his well-publicized Western belts with silver buckles and several retailers for selling the copies.

This is nothing new for Mr. Kieselstein-Cord, who collected out-of-court settlements from two manufacturers in 1975 for making versions of another belt buckle and a pin.

Few people seem to be aware that jewelry and sculpture may bear a copyright, as books do. Copyrights, registered with the Library of Congress, are now effective for the life of the creator plus 50 years. Fabric designs may also have a copyright, but not dress designs or fragrances.

Designers may also protect themselves by using trademarks and patents. A trademark refers to a name or symbol that identifies someone's product; a patent is for functional and design inventions.

Guarding the Company Name

Cartier, for example, has not taken legal action against those who have copied its venerable Tank watch, but does take legal action when people put the Cartier name on the watches and try to palm them off as genuine. That is infringement of its trademark, according to Cartier, as is the putting of the Cartier logo on items the company does not make, such as jeans and shirts.

"We've been involved in 250 lawsuits since 1976," said James L. Bikoff, secretary and general counsel of Cartier. "Before that, copying and counterfeiting were on a marginal basis. Now they're big business. Customs recently seized a shipment of 4,000 bogus Cartier watches coming in from Switzerland. We're even seeing copies of our Santos watch, which was only introduced last year."

Van Cleef & Arpels has acted when people borrowed its trademark, Minaudière, to describe any metal evening bag. When the Larousse dictionary added "small evening case" to its definitions of minaudière (a primping woman), Van Cleef won one franc in damages, plus deletion of the definition from subsequent editions.

Recently the jeweler has taken exception to imitations of its best-selling four-leaf-clover chain. Lawyers for Van Cleef have stopped copyists in Japan and are working on Italian ones.

Tiffany's president, Henry B. Platt, says: "I've been fighting this battle for over 30 years. "It's like fighting City Hall."

In recent years Elsa Peretti jewelry has been the copyists' favorite, he said, the most popular being Diamonds by the Yard (which is trademarked and copyrighted), teardrops, horseshoe belt buckles and, of course, the asymmetric open-heart that's one of Tiffany's all-time best sellers.

"That's the most flagrant copying I've ever seen," Mr. Platt said, referring to the heart. "Even our ads were copied. But trying to stamp it out is like trying to stamp out ants. It's very difficult to enforce copyright laws today in this field. All people have to say is they changed a design a little — improved on it."

Mr. Kieselstein-Cord does not take such a philosophical attitude. "My chief concern," the designer said recently, "is stopping pirates, curtailing plagiarism and diminishing the enthusiasm of counterfeiters. We're not a giant company with mass distribution. We're six craftsmen making handmade products to order."

His designs are Western-inspired lizard belts with silver buckles, tips and loops. They are made in two sizes, and range from $295 to $900 at retail; the copies are selling for $9 to $49.

So far Mr. Kieselstein-Cord's attorney has issued complaints against three manufacturers: Accessories by Pearl, Kandell & Marcus and Lee-Vic Industries.

Compared to Dress Design

Accessories by Pearl contends that Mr. Kieselstein-Cord's belt buckle is not subject to copyright protection any more than a dress design would be. "We also believe that the slight differences between his design and other Western-style buckles in the market are insufficient to justify a copyright," said John M. Degensheim, the company president. Kandell & Marcus is adopting the same position. And Lee-Vic Industries says that while it has never received a summons, it has stopped manufacturing the belts until the case is settled.

In addition, summonses have gone to two retailers, R. H. Macy & Company and Sportswork Inc. Spokesmen for both stores said the disputed merchandise has been removed from sale. Ann Taylor and Exceptional Women removed the merchandise from their shelves when notified by telegram.

"I hate to be Don Quixote chasing these people," Mr. Kieselstein-Cord said, "but I intend to follow through and go into litigation all across the country if I have to. One of the plagiarists actually said to me: 'What do we care about a copyright? We don't pay any attention to that.'"

Infringement of copyright may be punishable by fines, seizure and destruction of reproductions, injunctions against further infringement and damages. At this point Mr. Kieselstein-Cord is seeking preliminary injunctions to keep the belts from being manufactured and sold while the cases are in litigation.

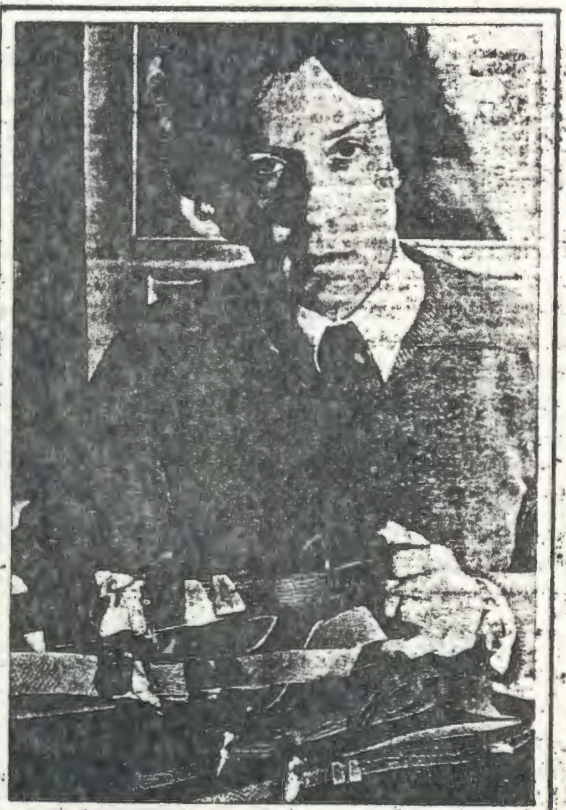
'A Grain of Salt'

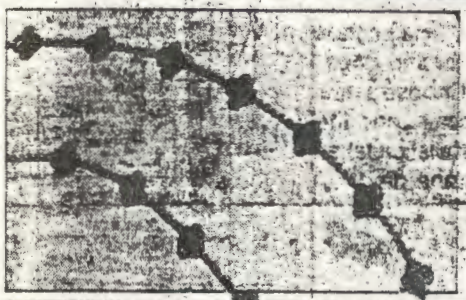
There are no guarantees that someone else will not copy the designs. Aldo Cipullo, designer of the much-copied Love bracelet, said: "At one time I used to be very upset when people copied me. Now I take it with a grain of salt. The thing to do is to keep creating."

Mr. Bikoff of Cartier said: "We've stopped many retailers, distributors and importers, but counterfeiting is so profitable that it continues." He estimates that 50 people a week take counterfeit watches to Cartier to be repaired. Ralph Destino, president of Cartier, said he often speaks with customers who are surprised to be told they have bought fakes: "I ask them what makes them think they can get a $580 watch for $100, and they say they thought it was hot."

In Mexico, Mr. Bikoff said, there are seven stores called Cartier that have no connection with his company: "We've been working with the Mexican Government, with customs, with ambassadors, with the courts," he went on, "and we can't do anything. The stores look really good, they use our logo, our packaging, they even copy our guarantees, so the tourists are fooled.

"Every time we win a case in the Mexican courts, the owners appeal and keep going. It's very frustrating."





Above, Barry Kieselstein-Cord with his belts and lighter colored imitations. Right, Elsa Peretti's heart pendant.

ndise, above left; Van
af-clover necklace, right.

The New York Times/Lenny C. Morris and William E. Sauro

MAY 15, 1980

RetailWeek

Gourmet food for gracious living

Regulatory briefs

Fred Meyer consents: Fred Meyer, a discount operation based in the Pacific Northwest, has agreed to a consent agreement with the Federal Trade Commission (FTC), according to which the retailer is required to refund money to layaway and charge customers. The FTC had alleged that Fred Meyer had improperly retained monies from such customers.

Rich's acquisition: The Federal Trade Commission has finally closed its investigation of Federated Department Stores' acquisition of Rich's in Atlanta. The agency had attempted to demonstrate that the merger was anticompetitive in that it allegedly reduced competition in the department store industry. However, after several years of investigation, the commission decided there was insufficient evidence to issue a complaint against the merger.

Clinique settles: Clinique Laboratories has entered into a consent order with the Federal Trade Commission whereby Clinique has agreed not to suggest retail prices for a three-year period beginning July 1. The consent order does not constitute an admission of wrong-doing.

Credit collection: The Federal Trade Commission (FTC) recently signed a consent agreement with Credit Index, a division of Hooper Holmes. Under the terms of the agreement, the New Jersey credit reporting agency is enjoined from using data-gathering and reporting methods that may result in some people being denied credit based on other people's paying habits.

Credit Index, which furnishes information mainly to mail-order businesses, was alleged to have prepared data based on last names and addresses as the only identification. The FTC said this practice resulted in credit being denied some people because of poor ratings of neighbors, relatives, former residents.

Junk phone calls: After two full years of looking into the problem of junk phone calls, the Federal Communications Commission has decided that its authority does not extend to intrastate calls and, therefore, will not take it upon itself to rule over such annoyances. Any action to prohibit junk calls is now in the hands of the state officials.

issues

A recent court decision gives style pirates more than a wooden leg to stand on; designers are the apparent losers, while retailers stand to gain.

Copyright protection is no cinch

A copyright infringement suit that has piqued much interest in the market of late centers on whether a belt buckle design can be knocked off. The plaintiff in this matter is Barry Kieselstein-Cord, a Coty-award-winning jewelry designer, whose works include two belt buckles originally cast in precious metals, called the "Winchester Buckle" and the "Vaquero Buckle." The defendant is Accessories by Pearl, a leading supplier of fashion accessories to department and specialty stores, which incorporated copies of the two buckles in its belt offerings.

It is important to note that Kieselstein-Cord and Accessories by Pearl deal in two distinct markets: the former's buckles are sold at jewelry counters at exclusive shops while the latter's belts are mass merchandised.

Federal judge Gerard Goettel of the Southern District of New York circuit recently denied the plaintiff's motion for an injuction, citing the uncopyrightability of the subject. Attorneys for Kieselstein-Cord say they will definitely appeal the ruling.

The entire issue rests on whether a belt buckle design can be protected by federal statute. Accessories by Pearl from the outset proceeded under the assumption that a buckle cannot: the firm admits purchasing the "Vaquero Buckle" for $600 from Henri Bendel and copying it line-for-line. The "Winchester Buckle" was purchased by the accessories manufacturer from a findings supplier.

The U.S. Copyright Office granted copyright Registration Certificates covering the buckles to Keiselstein-Cord, and this authorization—which was based on meeting the office's criteria—constitutes the cornerstone of the plaintiff's case. However, the position of the defense is that copyrights are frequently granted that do not hold up in court. The defendants insist that judicial interpretations of what is copyrightable supersede the Copyright Office's determinations. Moreover, they contend that litigation has never resulted in any decision to uphold a copyright for an artistic article similar to the buckles.

The belt buckle knock-offs
Held up in court

Two schools of thought are counterpoised in the discussions this case has provoked. Some, hoping Kieselstein-Cord will ultimately prevail, contend that style piracy is wrecking the apparel industry. Their argument goes thus: piracy diminishes creative effort because designers cannot protect their designs or even the integrity of their concepts. To illustrate this point, they point to the work of Elsa Peretti—the designer carried by Tiffany & Co. and considered to have influenced the direction of jewelry and related accessories more than any other person over the past several years.

Yet, Peretti's copyrighted designs—

for example, the asymmetrical heart, the bean and the tear drop—have been copied and marketed at every level of distribution, right down to the five-and-dime store, despite attempts by Tiffany to protect her work. In the process, the status originally associated with these designs diminished—which consequently reduced the appeal of the precious-metal originals. Such wholesale compromise of artistic achievement serve to discourage other artists from even trying to innovate, say the contingent in favor of stricter design copyright enforcement.

On the other side, there are strong arguments in favor of the defendant's position. Retailers, particularly, have a vested interest in preserving the precept of defacto copyright law that holds apparel designs fall into the public domain, which the body of court decisions seems to support. To wit, two precedent-setting cases involved retailers: Wm. Filene's Sons Co. v. Fashion Originators Guild (1937) and Societe Comptoir v. Alexander's Dept. Store (1962).

The accessories house in the present case argues that granting a copyright on a belt buckle or any other item of apparel would be tantamount to granting a monopoly on a basic construction of a particular merchandise category. The defense points out that in view of the obvious impact on competition this situation would create, Congress and the courts have refused to extend copyright protection to designs expressed in articles of clothing because an "original" creation is considered too slight a modification to justify the granting of a monopoly to the creator. (In this particular instance, the "Winchester" and the "Vaquero" are variations on the traditional western belt buckle.)

The defense brief reiterates a concept articulated in the aforementioned Alexander's decision, which was a landmark case concerning the copyrightability of wearing apparel: "The interest here of the consumer in competitive prices of garments [using Dior designs without deception as to origin] is at least as great as the interest of the plaintiff's in monopolizing the name."

The plaintiff insists the buckles are works of art rather than articles of apparel and, as such, are copyrightable. Ultimately, the appeals court decision will rest on what the court perceives ongress intended when it passed legislation to cover copyrights and patents.

The distinction between the two is set forth in the constitutional grant of powers of Congress. The legislative body is authorized to "promote the progress of science and the useful arts, by securing for limited terms to authors and inventors the exclusive right to their respective writings and discoveries." The "writings" of "authors" are protected by copyright laws; the "discoveries" of "inventors" are shielded from the public domain by patent laws.

The defense points out that the "writing" thus protected has been interpreted by the courts to mean the expression of an idea rather than the idea itself. (In a 1934 case, for example, the court held that "a dress is not copyrightable. A picture of a dress is." And, a 1977 case involving Trimfit mitten-toe/glove design socks determined the drawings of the stockings were copyrightable, but not the stockings themselves.) The defense argues the "expression" and the "idea" (i.e., the "writing") are one and the same in the form of a belt buckle.

The designer's attorneys argue that the buckle is a work of art (i.e., "a picture of a dress"), citing the fact that Kieselstein-Cord's buckles are "handmade, one-of-a-kind pieces in sterling silver and gold" and have been accepted for inclusion in the permanent collections of the Metropolitan Museum of Art as proof of their standing as art works.

However, Accessories by Pearl's attorneys thus far have successfully discredited this argument by applying two tests to the buckles that courts have traditionally used to determine whether objects should be afforded copyright protection: the "sole intrinsic function" and the "useful article" tests.

The copyright regulation itself reads: "If the sole intrinsic function of an article is utility, the fact that it is unique and attractively shaped will not qualify it as a work of art." The rule continues: "However, where the object is clearly a work of art in itself, the fact that it is also a useful article will not preclude its registration."

The defense emphasizes the initial wording while the plaintiff clings to the latter qualifying language, citing Mazer v. Stein which was heard by the Supreme Court in 1953. The case involved statuettes incorporated into lamps and the High Court determined that copyrightable "applied art" can encompass sculptural works embodied in useful articles.

However, the defense also cites Mazer v. Stein, going to great lengths to demonstrate variances in the shades of meaning between the Supreme Court's findings in that case and subsequent changes in the copyright regulation that mitigate against Kieselstein-Cord's proffered interpretation of Mazer. The brief for the accessories house notes that the statuettes at issue were separately copyrightable before their incorporation into lamps while Kieselstein-Cord's "art" cannot be separated from the buckles. The sole intrinsic function of this "art" is to serve the "utilitarian function" of holding up pants, skirts, etc., they argue; the artistic features are incapable of existing independent of the utilitarian aspects of the buckle.

Another similar case cited by the defense is Vacheron-Constantine-LeCoultre v. Benrus, wherein Benrus had copied a watch that bore a copyright notice. LeCoultre called the piece a "work of art," noting the watch did not resemble a watch in the usual sense. The court, however, observed that the copyright regulation "recognizes a penumbra where the object is so clearly a work of art that its utility will not preclude its registration. Such an object would be an engraved glass case. We are used to calling such things works of art. The wristwatch, however, is not within that class." Nor are we accustomed to calling buckles works of art, reasons the defense.

The philosophical character of these arguments make this case particularly interesting to follow because these same dialectics could apply to the growing categories of "designer" home furnishings and housewares should their design usurpation come up for judicial review. However, despite the ultimate disposition of this case, it is not likely to settle the questions pertaining to protection for commercial designs.

Since 1914, more than 70 design protection bills have been introduced to Congress, but none have been enacted. When Congress passed the Copyright Act of 1976, it rejected provisions that would have afforded limited protection to commercial designs—noting that "the whole realm of consumer products—garments, toasters, refrigerators, furniture, bath tubs, autos, etc.—and industrial products—subway cars, photocopy machines, typewriters, adding machines, etc." could qualify as works of art. Certainly, the incorporation of items such as a toilet brush, a typewriter, a stereo receiver and a car into the collections of the Museum of Modern Art attests to that line of reasoning.

Counsel for Accessories by Pearl pleads that the court "should not ignore this clear signal from Congress." Until Congress enacts a commercial design copyright law, argues the defense, it is not the proper function of the courts to enforce such protection.

In a related development, a judge in the same federal jurisdiction has taken signals from the marketplace for a legal interpretation of copyrightability. Judge Charles L. Brient, Jr., recently made a startling construction of the law by suggesting that market practices amount to de facto legal precedent.

The case involves Malden Mills, which sued Regency Mills for infringing on a copyrighted design used in upholstery fabrics. The judge ruled that Malden's copyright on their "Bridge" design was valid, but that Regency's variation of the pattern didn't infringe the copyright on

the basis that copying is an accepted way of doing business in the textile market. Malden has appealed the decision, citing the judge's admitting into the case as an excusable defense a prevailing low standard of morality in the industry.

If the Malden case stands on appeal, it will certainly constitute an unwelcome precedent for those favoring legal protection for commercial designs. If overturned, however, it will do little to bolster the corpus of legal precedent protecting design copyright—for the final word on ths controversial issue must come from Congress. ■

AT DAYTON'S
Selling small computers

Dayton's has taken another step toward elevating itself as the mission control center of Minneapolis. This past Christmas, about 60,000 customers punched the keyboard of the department store's computer gift registry. Then, at the beginning of April, Dayton's took another step forward into the hardware age and opened its Computer Center.

While many a department store offers small or home computers, Dayton's management believes that its approach to the Computer Center is unique among

The selling area reflects Dayton's professional approach

department stores. For starters, the computers being sold at Dayton's do not just sit on a shelf with a price tag attached to them. Dayton's has given the classification its own area of 1,600 sq. ft. of selling space; and the Center has been designed with semiprivate booths for consultations and teaching sessions.

The Computer Center is staffed by professionals who can explain computers in language which the customers understand.

The computers represented in the department are from six different manufacturers: Atari, Apple, Commodore, Texas Instruments, Dynabyte and PERTEC. The smaller computers range from $600 to $4000, while those which are more sophisticated and geared to small businesses range from $4,000 to $20,000.

The obvious question surrounding the launching of the Computer Center is: why would anyone go to Dayton's, or any other department store, to buy an expensive computer when the expertise of a typical department store's sales help does not extend beyond reciting the manufacturer's selling features enumerated on the manufacturer's hang tag?

Aware of this problem, Dayton's has another plan. Instead of operating the Computer Center on its own, the area is leased. The lessee is the Computer Depot, a Minneapolis-based retailer with a computer store of its own; and the Dayton's Computer Center is also a new venture in leasing for the Computer Depot.

Dayton's and the Depot got together because Dayton's management realized a computer area that is designed to sell the small business man as well as the home user and the hobbyist, had to be staffed by professionals who not only could talk the language of computers but also could speak in plain English about this newfangled hardware which most people still find to be strange and intimidating. As a result, Dayton's looked around for someone to run the department professionally and then selected the Computer Depot.

The store's Computer Center is designed to accomplish several things. One, its location in a department store is expected to expose more people to the benefits of computers since only those already interested in computers will walk into a free-standing computer store. Second, Dayton's intends to sell computers for business use since its staff will be able to listen to a businessman's needs, make recommendations on the proper computer and software, visit a potential customer's premises if necessary, and prepare custom computer programs. In addition, Dayton's will also offer maintenance contracts with the purchase of the more sophisticated machines offered.

The Computer Center has been open only since April 8, but Dayton's management has seen enough to call the traffic "phenomenal." As for sales volume, it is still too soon to say since it is estimated that it takes from 60 to 90 days from initial contact for a computer sale to be made. But, Dayton's does characterize computers as presenting "a major growth opportunity for the 1980s."

The Dayton's aproach to its Computer Center also make it obvious that a department store cannot expect to sell $10,000 computers, or even $1,000 computers in the same way it sells $20 shirts; that is, it is necessary to do a bit more than just put the merchandise out on the shelf. ■

AGE DISCRIMINATION
EEOC v. Labor

Up until approximately one year ago, the Department of Labor held jurisdiction over the Age Discrimination in Employment Act (ADEA). At that time, the Equal Employment Opportunity Commission (EEOC) assumed the reins and has since been working on a proposal that would change Labor's interpretation of ADEA.

According to the Department of Labor, the act permits employers to cease from providing pension benefit accruals and contributions to workers who continue to hold their jobs after the normal retirement age. As a result of this interpretation of the act, Labor does not believe that such action should be considered illegal age discrimination.

The EEOC strongly disagrees, and although the commission's proposal has not yet been finalized to alter this interpretation, a summary of it has recently been released. Generally, the proposal calls for the elimination of a blanket exclusion from providing defined benefit plans if the person in question is hired five years prior to retirement. In such a case, however, employers would be permitted to offer these pension benefits under a separate plan and would be permitted to reduce accruals as premium costs increased.

Secondly, when considering such defined contribution plans as profit-sharing and savings plans, employees would have to continue to be offered such programs. And, if other defined contribution plans are part of an employer package that has outlined goals, and these goals have not yet been met by normal retirement age, then the contributions would have to continue.

The EEOC has been working on a proposal that may, once again, alter Washington's views on employee pension plans.

Kieselstein-Cord ruling reversed on appeal

By TIM WEINER

NEW YORK (FNS) — Barry Kieselstein-Cord won a legal battle Monday to copyright his high-fashion belt buckles.

A federal appeals court in Manhattan split 2 to 1 on "a razor's edge of copyright law" and reversed a lower court's ruling that the belt buckles were "utilitarian" objects ineligible for copyright.

Judge James L. Oakes, writing for the majority, said "the buckles rise to the level of creative art" and satisfy "the basic requirements of originality and creativity...which all works of art must meet to be copyrighted."

The case of the Keiselstein-Cord belt buckles has been followed with intense interest by the fashion industry, long prone to design "knockoffs." If designers can prove to a court's satisfaction their work is "original" and "creative" rather than being merely utilitarian, a copyright would give them legal protection from copiers.

In a dissent, Judge Jack Weinstein said Kieselstein-Cord's works are "indubitably belt buckles and nothing else." Congress declined in 1975 to extend copyright protection to ornamental designs on useful articles. "It is not for this court to twist the law," Weinstein said.

Kieselstein-Cord, a 1979 Coty Award winner whose belt buckles are in the permanent collection of the Metropolitan Museum of Art, said Monday, "It's a marvelous thing, this decision. The imitators have done us an enormous amount of damage."

The designer sued Accessories by Pearl for pirating his Winchester and Vaquero belt buckle designs in 1979. The company admitted making and selling the imitations, but argued successfully before Federal Judge Gerard L. Goettel that Kieselstein-Cord's work was not "copyrightable."

On April 30, Goettel revoked copyrights for the buckles.

Attorneys for Kieselstein-Cord told the appeals court the designer's business would be "destroyed" if the court upheld Goettel's decision. The sculpted belt buckles accounted for 95 percent of Kieselstein-Cord's 1979 sales of more than $300,000.

The question before the appeals court was whether the buckles are art or articles with the sole function of keeping people's pants up. The majority of the three-judge panel found art and not mere craft in Kieselstein-Cord's work.

"Important policies are at stake," Weinstein said in his dissent. "Should we encourage the artist and increase the compensation to the creative? Or should we allow cheap reproductions which will allow our less affluent to afford beautiful artifacts?" the judge asked, noting a typical Kieselstein-Cord belt sold for $600 and up, while the knockoff cost $12.

"Thus far," Weinstein said, "Congress and the Supreme Court have answered in favor of commerce and the masses rather than the artists, designers and the well-to-do." The Kieselstein-Cord case, an apparent victory for "artists, designers and the well-to-do," now goes back to Federal District Court, where Kieselstein-Cord will seek damages for copyright infringement.

At Cartier, itself a victim of trade piracy, Ralph Destino, president, said he is "delighted" with the court decision, adding, "It moves us one step closer to the levels of protection that our copyright laws currently give to music, literature and fine art."

He said current copyright laws have "too many loopholes that permit knockoff artists" to trade on other people's creativity.

"This decision," Destino said, "will persuade us to be more aggressive in protecting the copyrights we own."

Walter Hoving, chairman of Tiffany & Co., declined to comment on the court decision, other than to say, "People knock off our stuff all the time. Our Try God pin, our Peretti heart, have been knocked off all over the place and we don't do anything about it."

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Handbags

Impact of buckle copyright ruling is unclear

By NANCY JOSEPHSON

NEW YORK — Barry Kieselstein-Cord, who this week won back the right to maintain copyright protection for his high-priced, high-fashion belt buckles, still is not out of the woods legally, and the impact of his court victory remains unclear.

His opponent, a New York beltmaking firm called Accessories by Pearl, is seeking to overturn a Second Circuit Court of Appeals ruling that restored Kieselstein-Cord's sole right to two belt buckle designs. The company has argued a belt buckle is not entitled to copyright protection.

The case is significant because it addresses a fine point in copyright law: the extent to which an artistic design can be protected when the work of art is incorporated into a utilitarian object.

The case goes back to 1979, when the designer says he discovered the beltmaker "pirating" his two buckles, making

Barry Kieselstein-Cord and his two buckles: Vaquero (top) and Winchester (lower).

WWD photo by TONY PALMIERI

"line-for-line" copies of the Winchester and Vaquero designs in base metal rather than sterling silver and selling them for considerably less.

The designer sued. But he lost on the first round and, on April 30, the copyrights were revoked. A federal district court said the buckles simply were "useful articles" with no features capable of existing independently of a buckle on a belt. Utilitarian objects — sweaters, pants, dresses, belt buckles — are not entitled to copyright protection, the court said.

Accessories by Pearl never denied copying Kieselstein-Cord's belt buckles. And, in court, nobody questioned the buckles' creativity or originality — conditions necessary to copyright works of art. The designer had applied for copyright of the pieces as "jewelry," a category for which protection is routinely granted.

To some, the decision of the appeals court broke no new ground. In restoring copyright protection to the high-priced buckles, the court simply reiterated what was understood all along.

"Frankly, I thought the whole concept of originality and utilitarian objects was buried a long time ago," said copyright attorney Bernard A. Heifat, a partner at Heifat & Heifat in New York. "The question is really whether the design is such that it demonstrates originality and creativity. If it does, the court will sustain or enforce the copyright."

The fact, of course, is that the lower court thought differently, but the appeals court ruling is bound to discourage pirating, particularly in accessories-related businesses. Cartier president Ralph Destino said the ruling has persuaded him to be more aggressive in "protecting the copyrights we own." Nevertheless, the decision is not expected to alter the manner of doing business on SA itself.

"Design patents for clothing were never really accepted in the courts," said Ben Barrack, a former dress manufacturer who, as head of the now defunct Fashion Originators Guild of America, led a movement to obtain copyrights for fashion designs. "Its impact on the dress industry — nothing. I don't think it means anything at all."

Barrack may, in fact, be right. In England, where fashion designers have legal recourse if they can provide signed, dated sketches and cutting patterns as well as evidence documenting when the goods were shown and sold, most simply don't bother chasing after the pirates. "The trouble with fashion is that by the time you take someone to court, the season is already gone," said John Siggins, business partner to designer John Bates.

In France, there are laws protecting apparel designs, but they rarely are used and infringement is difficult to prove, according to Herve Thireau, legal official at the Union des Fabricants, a group to which most French designers belong.

Kieselstein-Cord's victory may be a victory for artists as well. He views his buckles as sculpture "that just happens to be worn." He points out each of the pieces may be worn individually, as ornaments on a pin or as pendants at the neck.

Yet, on SA, fortunes are made knocking off someone else's designs.

"We haven't denied making (line-for-line) copies," said Bill Dudine, an attorney with Darby & Darby, counsel for Accessories by Pearl. "This type of thing is done frequently in the fashion business. It's like Ohrbach's having a copy of a Dior."

The problem with such thinking, some people say, is that other businesses get hurt. "Business just completely dropped dead after the copies came out," Kieselstein-Cord said.

Whether the ruling will spark a copyrighting trend among accessories manufacturers is still uncertain. For example, will people who design hair ornaments be entitled to protection? How about those who design ornaments for hats and handbags? Lawyers really don't know.

"I think this ruling goes beyond jewelry," said Ronald J. Levine, attorney at Phillips, Nizer, Benjamin, Krim & Ballon, counsel for Kieselstein-Cord. "If extended, the theory may protect designers whose works are incorporated into other works."